Hovsepian v. Apple, Inc. Doc. 193

ROUND 3 DEFENDANTS' DEMONSTRATIVE EXHIBITS
In re Acacia Media Technologies Corporation (Case No. C-05-01114 JW)
June 14-15, 2006 Markman Hearing

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TAB 1

“Performed By A Transmission System”

Point VIII of Round 3 Defendants’ Brief (Part I)

Timeline of ’992 Claim 41

Claim 41 added to application without the “performed by a transmission system” limitation

Examiner provided “comments” about claim 41 - he will “reconsider the allowability of the claim[] upon submission of the amendments”

Claim 41 allowed

October 1, 1991 Amendment	December 10, 1991 Office Action	December 20, 1991 Interview Summary	December 26, 1991 Response	February 5, 1992 Notice of Allowability

Claim 41 rejected over Abraham and Ulicki prior art

Applicants make one change to claim 41- they add the “performed by a transmission system” limitation

Change represented by applicants as “reflecting the suggestions made by the Examiner”

"Retrieving" Step Of Claim 41 Is Performed By The Transmission System

41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

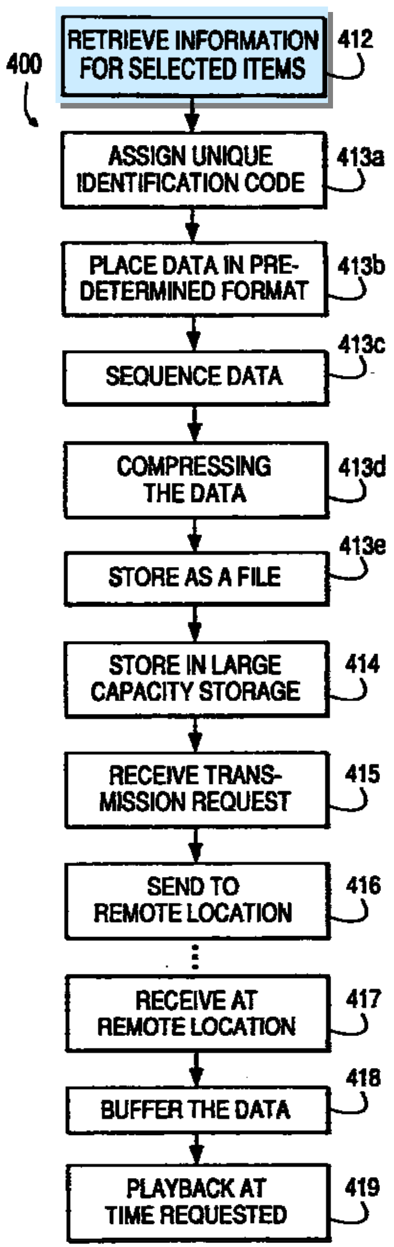
placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

sending at least a portion of the file to one of the remote locations.



400
RETRIEVE INFORMATION FOR SELECTED ITEMS
412
ASSIGN UNIQUE IDENTIFICATION CODE
413a
PLACE DATA IN PRE-DETERMINED FORMAT
413b
SEQUENCE DATA
413c
COMPRESSING THE DATA
413d
STORE AS A FILE
413e
STORE IN LARGE CAPACITY STORAGE
414
RECEIVE TRANS-MISSION REQUEST
415
SEND TO REMOTE LOCATION
416
RECEIVE AT REMOTE LOCATION
417
BUFFER THE DATA
418
PLAYBACK AT TIME REQUESTED
419

FIG. 7

Transmission System Component

"**identification encoding means** for retrieving the information for the items from the source material library means" ('992 Col. 2:31-33)

"Assigning" Step Of Claim 41 Is Performed By The Transmission System

41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

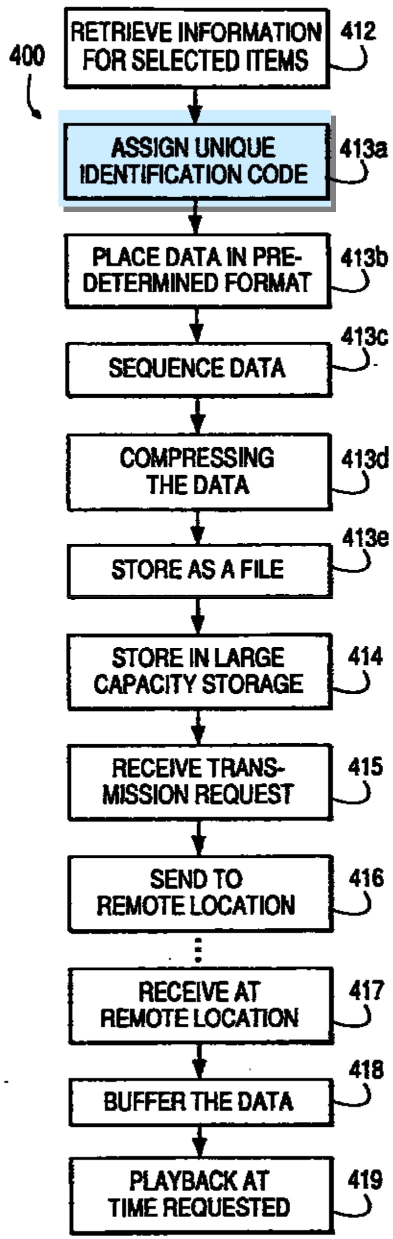
placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

sending at least a portion of the file to one of the remote locations.



400
RETRIEVE INFORMATION FOR SELECTED ITEMS
412
ASSIGN UNIQUE IDENTIFICATION CODE
413a
PLACE DATA IN PRE-DETERMINED FORMAT
413b
SEQUENCE DATA
413c
COMPRESSING THE DATA
413d
STORE AS A FILE
413e
STORE IN LARGE CAPACITY STORAGE
414
RECEIVE TRANS-MISSION REQUEST
415
SEND TO REMOTE LOCATION
416
RECEIVE AT REMOTE LOCATION
417
BUFFER THE DATA
418
PLAYBACK AT TIME REQUESTED
419

FIG. 7

Transmission System Component

"The processing performed in step 413 preferably includes assigning a unique identification code to the retrieved information **performed by identification encoder 112** shown and described with respect to FIG. 2a (step 413a)" (18:63-69)

“Placing” Step Of Claim 41 Is Performed By The Transmission System

41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

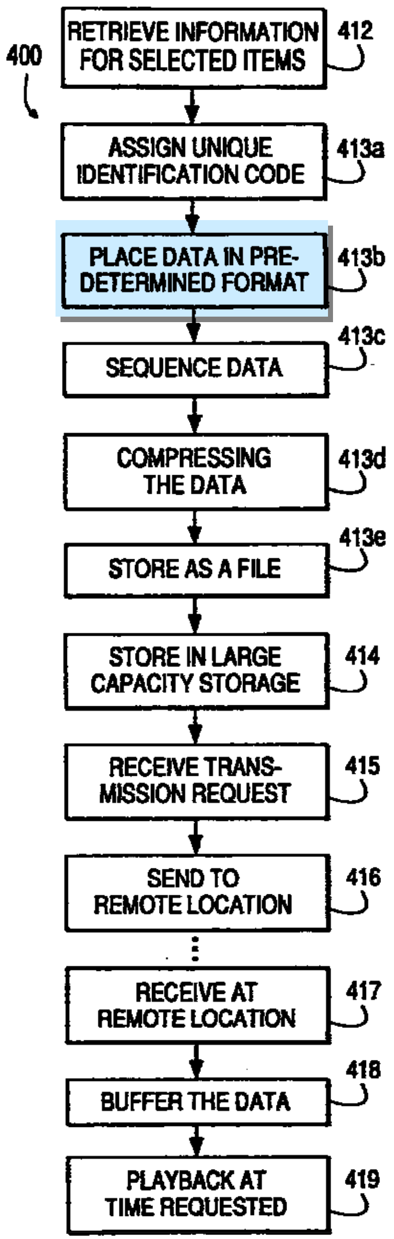
placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

sending at least a portion of the file to one of the remote locations.



400
RETRIEVE INFORMATION FOR SELECTED ITEMS
412
ASSIGN UNIQUE IDENTIFICATION CODE
413a
PLACE DATA IN PRE-DETERMINED FORMAT
413b
SEQUENCE DATA
413c
COMPRESSING THE DATA
413d
STORE AS A FILE
413e
STORE IN LARGE CAPACITY STORAGE
414
RECEIVE TRANS-MISSION REQUEST
415
SEND TO REMOTE LOCATION
416
RECEIVE AT REMOTE LOCATION
417
BUFFER THE DATA
418
PLAYBACK AT TIME REQUESTED
419

FIG. 7

Transmission System Component

“The processing also preferably includes placing the retrieved information into a predetermined format as formatted data **by converter 113** (step 413b)” (18:65-19:2)

Second “placing” Step Of Claim 41 Is Performed By The Transmission System

41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

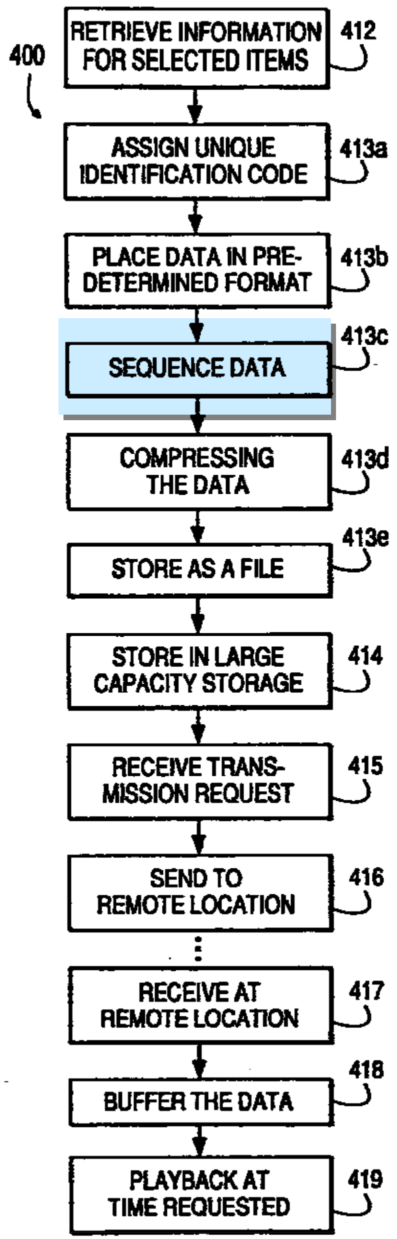
placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

sending at least a portion of the file to one of the remote locations.



400
RETRIEVE INFORMATION FOR SELECTED ITEMS
412
ASSIGN UNIQUE IDENTIFICATION CODE
413a
PLACE DATA IN PRE-DETERMINED FORMAT
413b
SEQUENCE DATA
413c
COMPRESSING THE DATA
413d
STORE AS A FILE
413e
STORE IN LARGE CAPACITY STORAGE
414
RECEIVE TRANS-MISSION REQUEST
415
SEND TO REMOTE LOCATION
416
RECEIVE AT REMOTE LOCATION
417
BUFFER THE DATA
418
PLAYBACK AT TIME REQUESTED
419

FIG. 7

Transmission System Component

“placing the formatted data into a sequence of addressable data blocks **by ordering means 114** (step 413c)” (19:3-4)

"Compressing" Step Of Claim 41 Is Performed By The Transmission System

41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

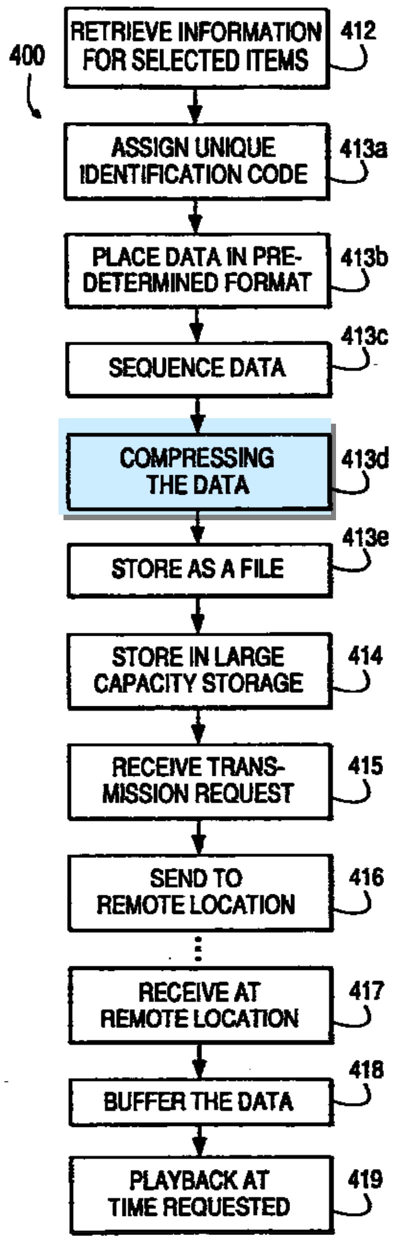
placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

sending at least a portion of the file to one of the remote locations.



400
RETRIEVE INFORMATION FOR SELECTED ITEMS
412
ASSIGN UNIQUE IDENTIFICATION CODE
413a
PLACE DATA IN PRE-DETERMINED FORMAT
413b
SEQUENCE DATA
413c
COMPRESSING THE DATA
413d
STORE AS A FILE
413e
STORE IN LARGE CAPACITY STORAGE
414
RECEIVE TRANS-MISSION REQUEST
415
SEND TO REMOTE LOCATION
416
RECEIVE AT REMOTE LOCATION
417
BUFFER THE DATA
418
PLAYBACK AT TIME REQUESTED
419

FIG. 7

Transmission System Component

"compressing the formatted and sequenced data **performed by data compressor 116** (step 413d)" (19:5-7)

Second "storing" Step Of Claim 41 Is Performed By The Transmission System

41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

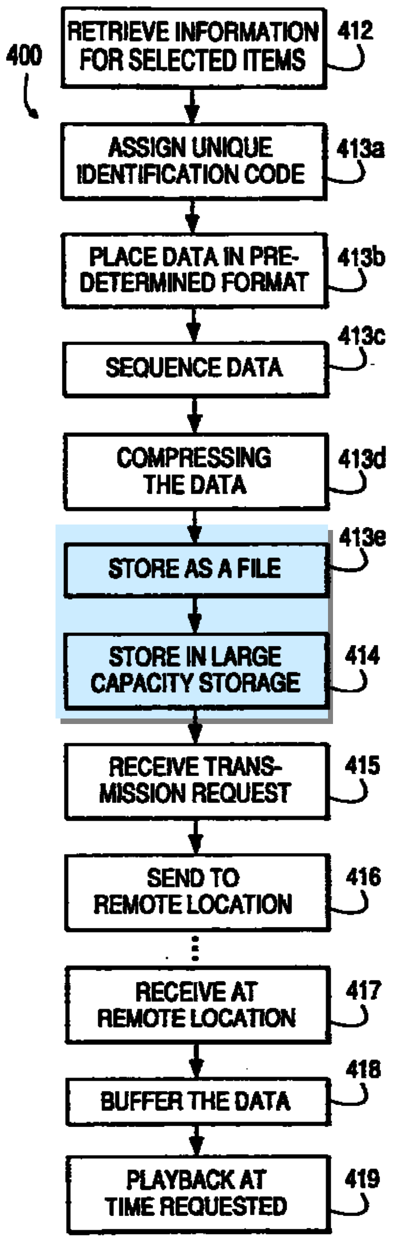
placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

sending at least a portion of the file to one of the remote locations.



400
RETRIEVE INFORMATION FOR SELECTED ITEMS
412
ASSIGN UNIQUE IDENTIFICATION CODE
413a
PLACE DATA IN PRE-DETERMINED FORMAT
413b
SEQUENCE DATA
413c
COMPRESSING THE DATA
413d
STORE AS A FILE
413e
STORE IN LARGE CAPACITY STORAGE
414
RECEIVE TRANS-MISSION REQUEST
415
SEND TO REMOTE LOCATION
416
RECEIVE AT REMOTE LOCATION
417
BUFFER THE DATA
418
PLAYBACK AT TIME REQUESTED
419

FIG. 7

Transmission System Component

"the compressed audio and video data is preferably formatted and placed into a single file **by the compressed data storage means 117**" (10:23-26)

"the distribution method 400 of the present invention preferably includes the step of storing the processed information is stored in a compressed data library (step 414). Preferably, the compressed data library is analogous to **compressed data library 118**, described with respect to FIG. 2a." (19:12-17)

“Sending” Step Of Claim 41 Is Performed By The Transmission System

41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

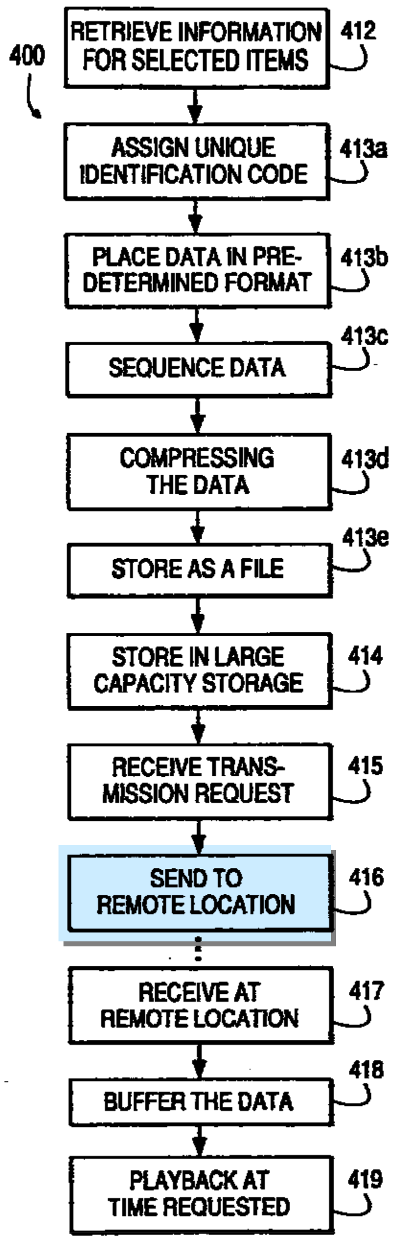
placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

sending at least a portion of the file to one of the remote locations.



400
RETRIEVE INFORMATION FOR SELECTED ITEMS
412
ASSIGN UNIQUE IDENTIFICATION CODE
413a
PLACE DATA IN PRE-DETERMINED FORMAT
413b
SEQUENCE DATA
413c
COMPRESSING THE DATA
413d
STORE AS A FILE
413e
STORE IN LARGE CAPACITY STORAGE
414
RECEIVE TRANS-MISSION REQUEST
415
SEND TO REMOTE LOCATION
416
RECEIVE AT REMOTE LOCATION
417
BUFFER THE DATA
418
PLAYBACK AT TIME REQUESTED
419

FIG. 7

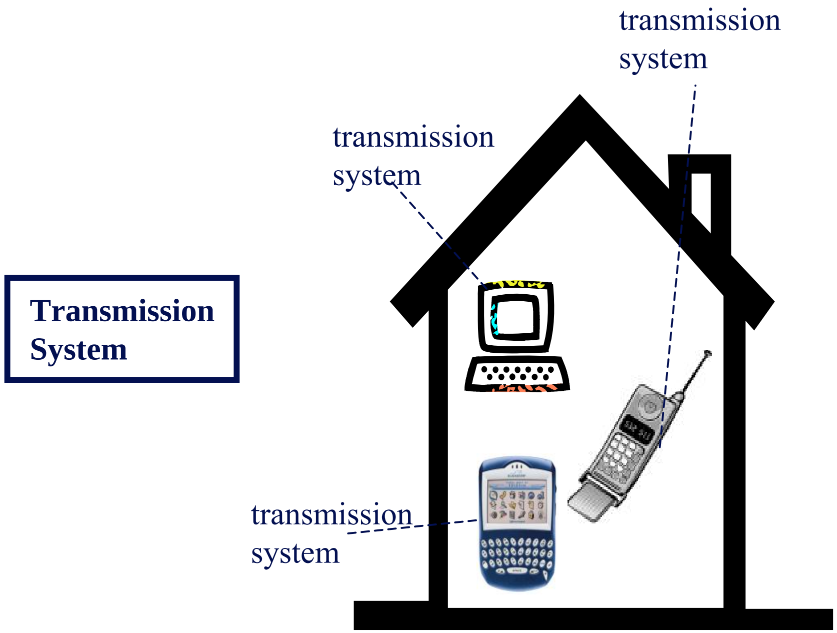
Transmission System Component

“The requested item is then sent to the user via the **transmitter 122** or directly via interface 121.” (13:45-47)

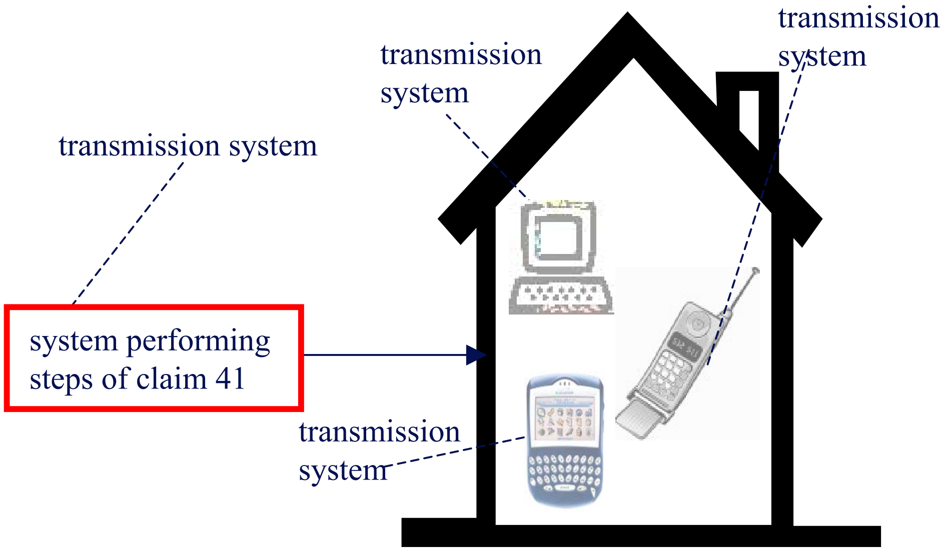
Transmission System Must Perform Steps Of Claim 41

Under Acacia's construction, there is no way to tell which "transmission system" the "remote location" must be "remote" from

"Transmission system" is a "reference point" only if the preamble requires that the "remote location" be remote from the transmission system which performs all of the steps of claim 41


Transmission System
transmission system
transmission system
transmission system

Is this a "remote location"?


transmission system
system performing steps of claim 41
transmission system
transmission system
transmission system

This is a "remote location."

TAB 2

“Items Containing (or Having) Information”

Point I(C) of Round 3 Defendants’ Brief (Part I)

Construction Of “Items Containing Information”

- **A previously-construed term which the Round 3 defendants will address in detail in the next round of claim construction**
- “Items containing information” must at a minimum refer to the physical items in the source material library that store information, and not the information itself (as Acacia alleges)
  - Acacia’s construction is inconsistent with the plain meaning of “items containing information” (“items containing information” cannot mean “information”)
  - Claim 19 (application claim 18) was amended during prosecution, in response to an examiner prior art rejection, to change “information” to “items containing information.” See 10/1/91 Amendment (Benyacar Decl. Ex. E.) p. 5:

> 18. (Amended) A distribution method responsive to requests identifying items containing information to be sent from a transmission system to remote locations, the method comprising the steps of:
>
> storing [audio and video] information from items in a compressed data form . . .

– Acacia’s construction would render this amendment a nullity

TAB 3

“Ordering The Converted Analog Signals And Formatted Digital Signals Into A Sequence Of Addressable Data Blocks”

“Wherein The Information In The Items Includes Analog And Digital Signals”

Point VII of Round 3 Defendants’ Brief (Part I)

Information From Multiple Items Must Be Put In "A" Sequence

19. A distribution method responsive to requests from a user identifying **items** in a transmission system **containing information** to be sent from the transmission system to receiving systems at remote locations, the method comprising the steps of: * * *

20. The distribution method as recited in claim 19, wherein **the information in the items includes analog and digital signals**, and wherein the step of storing the information comprises the steps, performed by the transmission system, of:

converting the analog signals of the information to digital components;

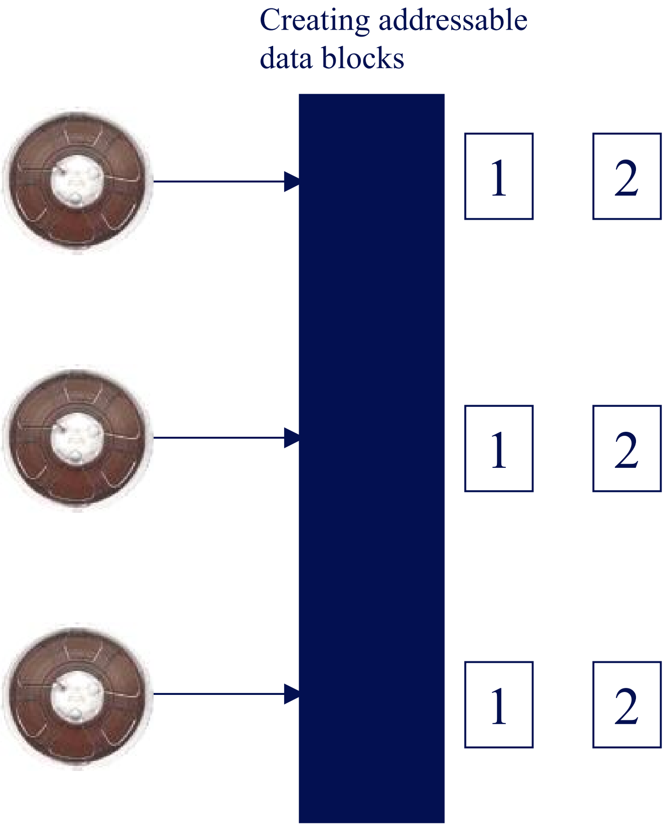
formatting the digital signals of the information;

ordering the converted analog signals and the formatted digital signals into **a sequence of addressable data blocks** and;

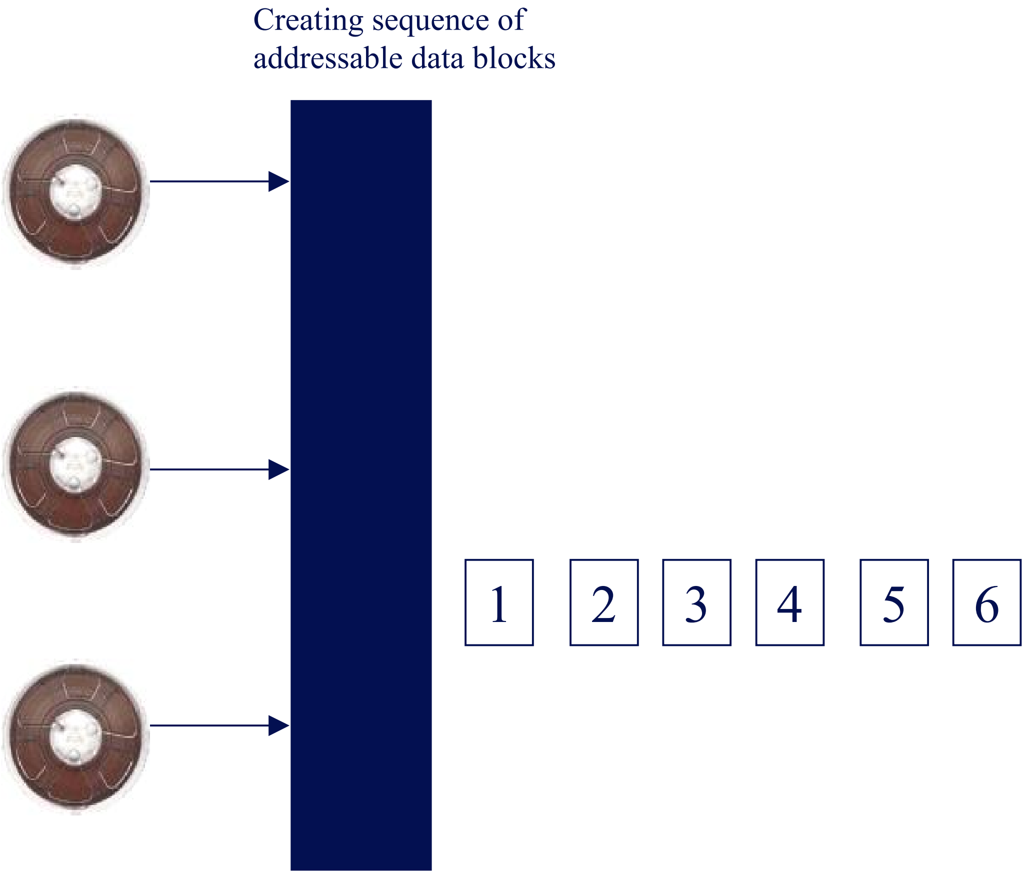
compressing the ordered information.

The Information From The Plurality Of Items

Not in "a sequence"


Creating addressable
data blocks
1
2
1
2
1
2

In "a sequence"


Creating sequence of
addressable data blocks
1
2
3
4
5
6

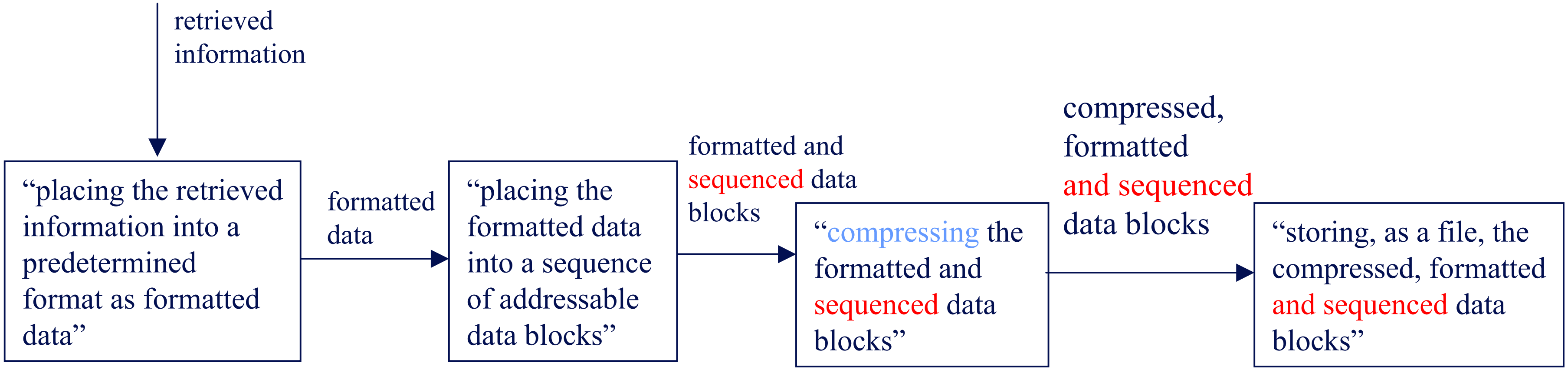
TAB 4

“Compressing The Formatted And Sequenced Data Blocks”

Point XV of Round 3 Defendants’ Brief (Part I)

Compressing The Formatted And Sequenced Data Blocks (Claim 41)

Construction: Compression begins and occurs only after the steps of "placing the retrieved information into a predetermined format as formatted data" and "placing the formatted data into a sequence of addressable data blocks" have been completed. The sequence of the formatted data blocks must be maintained by the compression process.


retrieved information
"placing the retrieved information into a predetermined format as formatted data"
formatted data
"placing the formatted data into a sequence of addressable data blocks"
formatted and sequenced data blocks
"compressing the formatted and sequenced data blocks"
compressed, formatted and sequenced data blocks
"storing, as a file, the compressed, formatted and sequenced data blocks"

TAB 5

The Order Of The Steps Of Claim 41

Point XVII of Round 3 Defendants' Brief (Part I)

Each Step Of Claim 41 Must Be Complete Before The Next Step Begins

Each step requires that the processing be performed on the product of the immediately prior step

retrieved information

“placing the retrieved information into a predetermined format as formatted data”

formatted data

“placing the formatted data into a sequence of addressable data blocks”

formatted and sequenced data blocks

“compressing the formatted and sequenced data blocks”

compressed, formatted and sequenced data blocks

“storing, as a file, the compressed, formatted and sequenced data blocks”

sending …the file

The Specification Teaches Only A Sequential Process (One After The Other)

41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

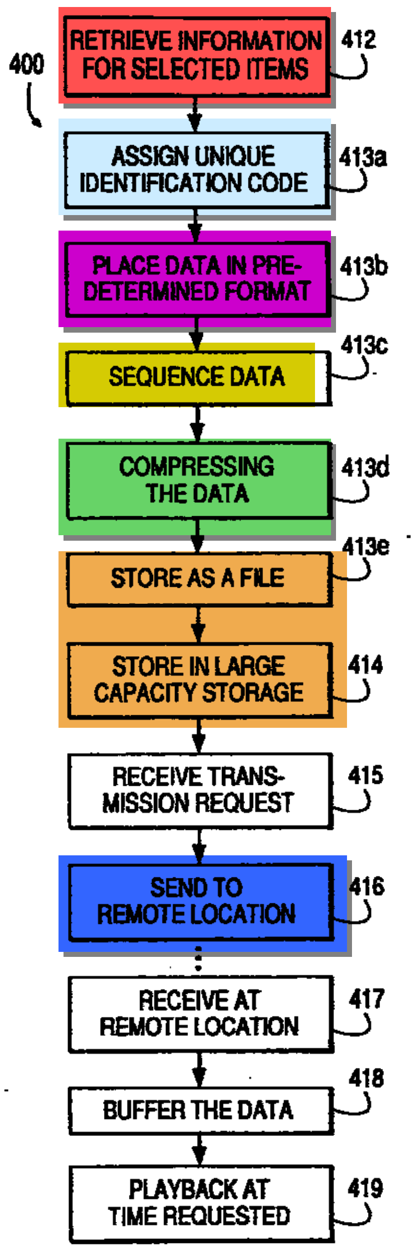
placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

sending at least a portion of the file to one of the remote locations.



400
RETRIEVE INFORMATION FOR SELECTED ITEMS
412
ASSIGN UNIQUE IDENTIFICATION CODE
413a
PLACE DATA IN PRE-DETERMINED FORMAT
413b
SEQUENCE DATA
413c
COMPRESSING THE DATA
413d
STORE AS A FILE
413e
STORE IN LARGE CAPACITY STORAGE
414
RECEIVE TRANS-MISSION REQUEST
415
SEND TO REMOTE LOCATION
416
RECEIVE AT REMOTE LOCATION
417
BUFFER THE DATA
418
PLAYBACK AT TIME REQUESTED
419

FIG. 7

The Specification Teaches That Claim Steps Are Performed Sequentially (One After The Other)

– **“[A]fter** identification encoding is performed by identification encoder 112, the retrieved information is placed into a predetermined format as formatted data by the converter 113.” (‘992 patent, 6:59-62)

– “**After** the retrieved information is converted and formatted by the converter 113, the information may be time encoded by the time encoder 114.” (‘992 patent, 7:64-66)

– “**After** compression processing by compressor 116, the compressed audio and video data is preferably formatted and placed into a single file by the compressed data storage means 117.” (‘992 patent, 10:23-26)

– “**After** the data is processed into a single file by the compressed data storage means 117, it is preferably stored in a compressed data library 118.” (‘992 patent, 10:36-39)

Oak Tech v. I.T.C. Rejected Acacia's Argument

"Acacia contends that the compressing step may commence *before all* of the information has been placed into a sequence of addressable data blocks." (Acacia Reply, p. 41.)

Acacia misreads *Oak*

Court's construction of method claim:

1. "**patent first performs error correction on an entire Sector of data**"
2. "**and then performs error detection with a cyclic redundancy checker on the entire corrected Sector of data.**"

– *Oak Technology, Inc. v. ITC*, 248 F.3d 1316, 1328 (Fed. Cir. 2001)

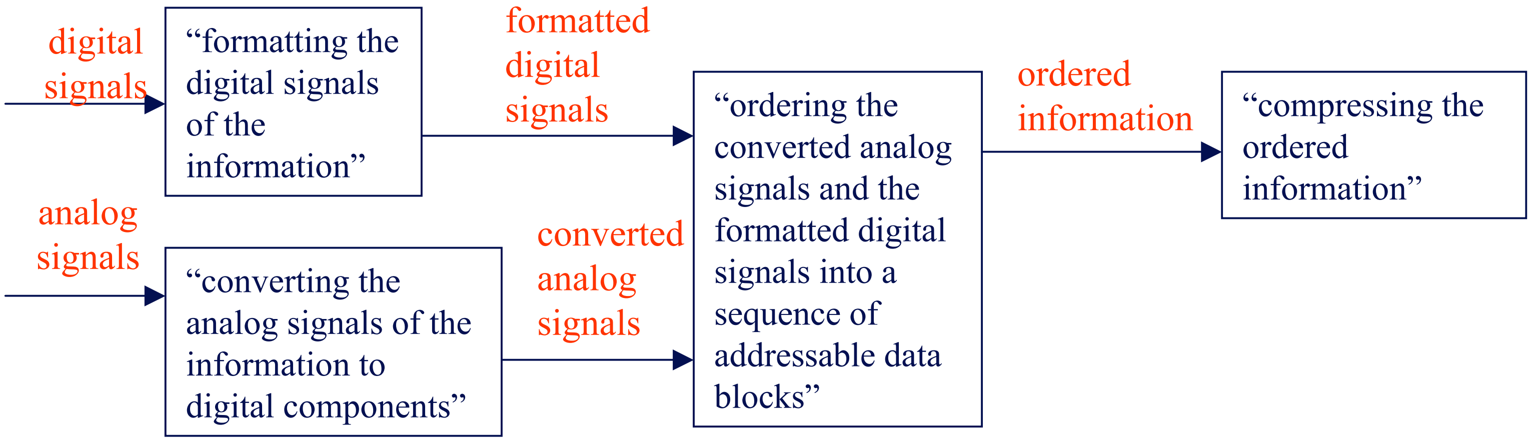
TAB 6

The Order Of The Steps Of Claim 20

Point IX of Round 3 Defendants' Brief (Part I)

Each Step Of Claim 20 Must Be Complete Before The Next Step Begins

Each step requires that the processing be performed on the product of the immediately prior step


digital signals
"formatting the digital signals of the information"
analog signals
"converting the analog signals of the information to digital components"
formatted digital signals
converted analog signals
"ordering the converted analog signals and the formatted digital signals into a sequence of addressable data blocks"
ordered information
"compressing the ordered information"

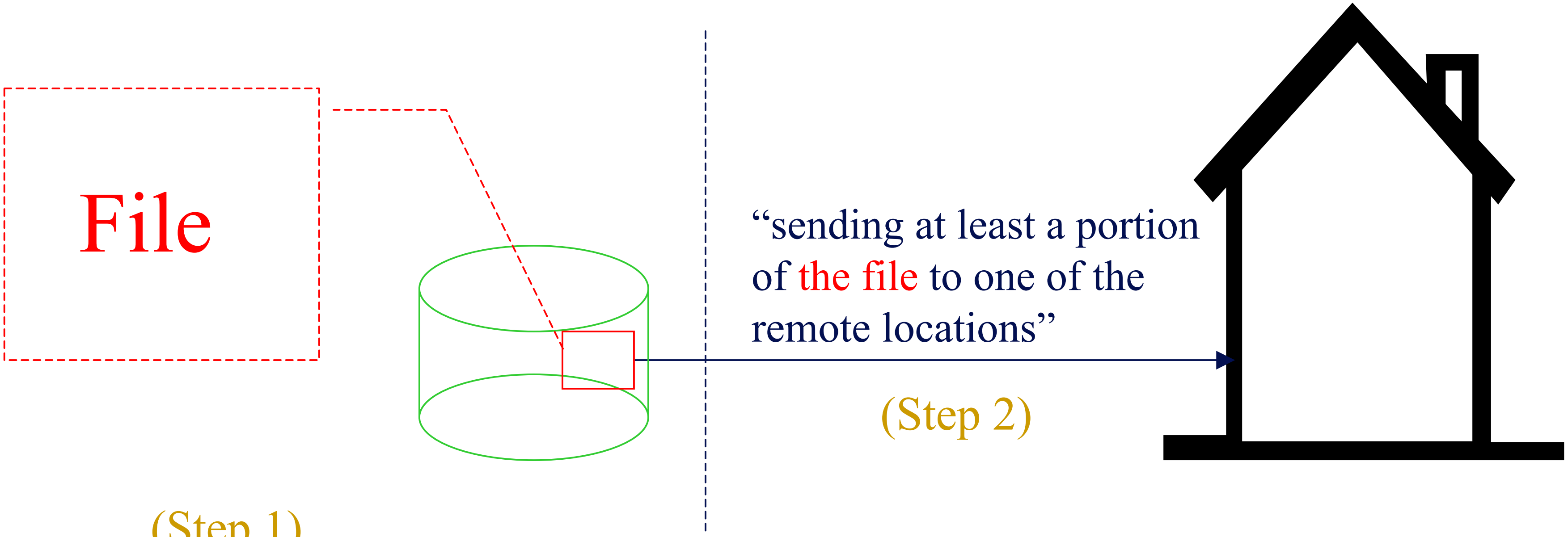
TAB 7

Sending At Least A Portion Of The File To One Of The Remote Locations

Point XVI of Round 3 Defendants’ Brief (Part I)

Sending At Least A Portion Of The File To One Of The Remote Locations (Claim 41)

Construction: At least a portion of the file that was stored in the preceding step of claim 41 of "storing, as a file, the compressed, formatted and sequenced data blocks with the assigned unique identification code" is taken from the place where the information was stored in the preceding step of storing and is sent to one of the remote locations.


File
"sending at least a portion of the file to one of the remote locations"
(Step 2)

(Step 1)

"storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code"

TAB 8

‘992 Claim 45

Point XXI and XXII of Round 3 Defendants’ Brief (Part I)

Claim 45, Unlike Claim 41, Provides No Indication Of Where The "Compressed, Sequenced Data Blocks" Come From

41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code, and

sending at least a portion of the file to one of the remote locations.

45. A transmission method as recited in claim 41, wherein the storing step further comprises the step of:

separately storing a plurality of files, each including compressed, sequenced data blocks.

Which compressed, sequenced data blocks?

Claim 45's Step of Storing "a Plurality of Files" Renders The Claim 41 Step Of "Sending … The File" Indefinite

41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

a plurality of files

storing, as ~~a file~~, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

Claim 45 provides no indication of which of "a plurality of files" is "the file" that is sent

sending at least a portion of the file to one of the remote locations.

45. A transmission method as recited in claim 41, wherein the storing step further comprises the step of:

separately storing a plurality of files, each including compressed, sequenced data blocks.

Order Of Steps Of Claim 45

- If it was possible to construe claim 45, the step of claim 45 would have to occur during the “storing, as a file” step of claim 41, not before or after
  - Claim 45 requires that “the step of placing” of claim 41 “*further comprises*” the steps of claim 45

TAB 9

‘992 Claim 46

Point XXIII and XXIV of Round 3 Defendants’ Brief (Part I)

’992 Claim 46

- Claim 46 is indefinite because claim 45, from which claim 46 depends, is indefinite
- The steps of claim 46 must be performed in the order recited

TAB 10

“Selected Remote Location”

“Remote Location[] Selected by the User”

Point III Of Round 3 Defendants’ Brief (Part I)

“Selected Remote Location”
“Remote Location Selected by the User”

Construction

When the user requests “at least a part of the stored information,” the user chooses the premises, from among a plurality of (two or more) premises, to which the information will be sent. Each of the premises from which the user chooses has a receiving system to which the information can be transmitted. The premises chosen by the user must be different from the premises at which the user makes the request.

The request by the user to the transmission system “for at least a part of the stored information” must include an identification of the specific remote location selected by the user.

Outline Of Argument

1) “Remote location,” In The Context Of User Selection Of A Location To Receive Information, Means Remote From The Location Where The User Does The Selecting

   A. the specification teaches this

   B. the specification distinguishes claim 19 from prior art on this basis

   C. applicants distinguished claim 19 from prior art on this basis during prosecution

   D. the Court did not previously construe this term

2) “Selected” Means The User Selects From Two Or More Locations, All Of Which Have Receiving Systems

3) The Request By The User To The Transmission System For Information Must Include An Identification Of The Remote Location Which The User Selected

4) “Location” In The Context Of A User “selected remote location” Means “Premises”

1) "Remote location," In The Context Of User Selection Of A Location To Receive Information, Means Remote From The Location Where The User Does The Selecting

A. the specification teaches this

> [T]he user may **remotely access** the transmission system **from a location different than the location of [the] reception system where the material will be sent** and/or played back. Thus, for example, a user may preferably call [the] transmission system from work and have a movie sent to their house… (Col. 5:15-20.)

- none of the excerpts from the specification relied on by Acacia teach an alternative embodiment.
- even if the specification taught an alternative embodiment, the applicants did not claim it

1) "Remote location," In The Context Of User Selection Of A Location To Receive Information, Means Remote From The Location Where The User Does The Selecting

B. the specification distinguishes claim 19 from prior art on this basis

While the [Walter] system affords the viewer some control over accessing the material, it requires that a location designated by the viewer be wired with a dedicated cable. **The Walter system further requires the viewer be at that location for both ordering and viewing the audio/video material**. (Col. 1:23-29)

Lang does not disclose a system with one or more libraries wherein a plurality of system subscribers may access information stored in the film and tape library or libraries, and **play back the selected information at a time and place selected by the subscriber**. (Col. 1:51-56)

Acacia affirmatively argued that these distinctions apply to claims in which the user selects a remote location (such as '992 claim 19) in a prior claim construction brief:

embodiments of their invention of different scope, including ones in which the transmission is to a reception system at a remote location, without any limitation on the remote location being user-selectable. By providing a number of embodiments in the specification and by not limiting the specification to an invention that is narrower than the claim language might imply, the inventors have supported embodiments of their invention where the remote locations are not selectable by the user, thereby not limiting their disclosure to only remote locations that are user-selectable. See, Mantech Environmental Corp. v. Hudson Environmental Services, Inc., 152 F.3d 1368, 1374 (Fed. Cir. 1998) ("If the written description supports the definition of the term that is apparent from the claim limitation, then reading in a further limiting definition would be improper."); Specialty Composites v. Cabot Corp., 845 F.2d 981, 987 (Fed. Cir. 1988) ("Where a specification does not require a limitation, that limitation should not be read from the specification into the claims.").

Defendants' proposed construction is therefore incorrect for the additional reason that it improperly seeks to import limitations from the specification into the claims. See, Sjolund v. Musland et. al., 847 F.2d 1573, 1581 (Fed. Cir. 1988) ("[W]hile it is true that claims are to be interpreted in light of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims.") This is why the Examiner in the '720 patent refused to adopt the construction proposed now by the defendants. (Exhibit 17 to Supp. App.)

There is no question that the inventors disclosed other embodiments for their invention, one of which included a user being able to select the location to which the transmission would be made. There is also no question that the inventors distinguished prior art references on this and on many other grounds in the specification and the prosecution history.[6] This was proper, because the inventors had

[6] Walter—See, '992 patent, 1:23-26; PTMS, Miller Decl., Exhibit B at 157-158; Lang—See, '992 patent, 1:51-56; PTMS, Miller Decl., Exhibit B at 154-155 and

pending claims, such as original claim 18 (claim 19 of the '992 patent), which specifically stated that the transmission is to remote locations selected by the user. But this does not mean that the inventors meant to limit their invention in its entirety to "user selectable" remote locations or that the inventors intended to disavow claim scope and require that the phrase "remote locations" should not be given its ordinary and customary meaning. See, Schwing GMbH v. Putzmeister Aktiengesellschaft, 305 F.3d 1318, 1325 (Fed. Cir. 2002) (prosecution history statements did not provide a narrowing definition with reasonable clarity and deliberateness where patentee identified several disadvantages of prior art reference); Read Corp. v. Portec, Inc., 970 F.2d 816, 824 (Fed. Cir. 1992) ("Read distinguished . . . the Deister reference because of a wealth of differences. . . . Thus, any estoppel created by Portec's argument encompasses all of these combined distinctions of Deister and not an estoppel respecting each of the individual differences.")

Nowhere do the inventors state, nor is it implicit, based on any statement, that the claim phrase "remote locations" must take on a meaning different than its ordinary and customary meaning or that this phrase means "more than one location selected by the user." Defendants have therefore failed to show through their many citations to the specification and to the prosecution history, that the inventors explicitly limited their invention to a single embodiment—i.e., one in which the user must select the remote location.

B. The Phrase "Library Means For Storing Items Having Information" Is Not a Means-Plus-Function Limitation

The parties have two disputes relating to this phrase. First, they dispute whether the phrase should be construed as a means-plus-function limitation. Second,

September 30, 1991 Response to Office Action, Miller Decl., Exhibit B at 208-209; Monslow—See, '992 patent, 1:30-38; PTMS, Miller Decl., Exhibit B at 155-156; Fenwick—See, PTMS, Miller Decl., Exhibit B at 159-60; September 30, 1991 Response to Office Action, Miller Decl., Exhibit B at 212-214.

1) "Remote location," In The Context Of User Selection Of A Location To Receive Information, Means Remote From The Location Where The User Does The Selecting

C. applicants distinguished claim 19 from prior art on this basis during prosecution

> Fenwick et al., also does not disclose a system in which a user can select a remote location to which a selected item is sent. Rather, in Fenwick et al., a selection can only be sent to the video monitor from which the user issues commands. . . (Benyacar Decl. Ex. E, 10/1/91 Amendment, ('992) p. 23.)

- the applicants relied on this feature repeatedly during prosecution:
  - "Although the system affords the viewer some control over accessing the material, it requires that a location designated by the viewer be wired with a dedicated cable. The Walter system further requires that the viewer be at that location for both ordering and viewing the audio/video material." (Benyacar Decl. Ex. B, '992 Prosecution History, Petition to Make Special, p. 9.)
  - "The present invention affords the user greater access to and control over audio and video information than is possible in conventional systems. With the present invention, a user can request audio and video information to be sent to a selected destination." (*Id.* at 2.)
  - "Further, in Monslow et al., the viewer-chosen program is transmitted to the television receiver of the requesting viewer. The requestor therefore does not have a choice of where the information that they request is sent." (*Id.* at 8.)

1) "Remote location," In The Context Of User Selection Of A Location To Receive Information, Means Remote From The Location Where The User Does The Selecting

D. the Court did not previously construe this term

- Court held "remote location" means "remote from some identified place"
- Only in the context of claims 1 and 41 did the Court find that "remote location" means remote from the transmission system

> The Court finds that the ordinary meaning of the term "remote locations" is "positions or sites distant in space **from some identified place**." **In the context of claims 1 and 41**, the ordinary meaning of the term is "positions or sites distant in space from the transmission system."

- The Court also observed that claims 2, 19 and 47, unlike claims 1 and 41, contain the additional limitation of selection by a user (Markman I pp. 4-5)

2) “Selected” Means The User Selects From Two Or More Locations, All Of Which Have Receiving Systems

- “Selected” means the user selects from two or more locations
  - The dictionary defines “select” as “chosen from a number or group by fitness or preference.” Webster’s Third New International Dictionary, p. 2058 (2002)
  - Acacia’s agrees
- Each of the plurality of locations from which the user can select has a receiving system
  - “Selection” means that the user can choose from among multiple remote locations that are equipped to receive the transmission.
  - If a location does not have the ability to receive the transmission (because it lacks a receiving system), the user cannot select it as the location to which the information will be sent.
  - The specification supports this:

    “A still further object of the present invention is to provide a picture and sound transmission system wherein the selected audio/video material is sent . . . *to any location chosen by the user that has a specified receiver.*” (Col. 1:67 - 2:4.)

3) The Request By The User To The Transmission System For Information Must Include An Identification Of The Remote Location Which The User Selected

- Every disclosed embodiment includes user selection, **at the time the request for information is made**, of the location where the information is to be sent:
  - As shown in Figure 3 (Sheet 7 of 12), after confirming his or her selection, the user "inputs a desired delivery time and delivery location." (Col. 14: 32-33.)
  - "After the desired item is found, the user selects the item for transmission at a specific time and location." (Col. 15:20-22, describing Fig. 4.)

Acacia affirmatively argued in a previous claim construction brief that the user request for information includes the selection of the remote location:

out' the limitations contained in the claim language.'"). This, in and of itself, should be enough to show that Defendants' construction is incorrect.

As shown in Acacia's opening brief, there is a heavy presumption that the phrase "remote locations" is construed as having its ordinary and customary meaning when read in the context of the claim language. (Op. Br. P. 11). Acacia's proposed construction is consistent with this meaning and defendants have not overcome this heavy burden.

2. Defendants Are Improperly Attempting to Import Limitations from Claims 19 and 47 into Claims 1 and 41

Defendants argue that the meaning of the phrase "remote locations," as used in claims 1 and 41, can be determined from examining the use of "remote locations" in claims 19 and 47. Claims 19 and 47 actually confirm Acacia's proposed construction.

Claims 19 and 47, unlike claims 1 and 41, contain explicit limitations that information be sent to "remote locations selected by the user.[3] Contrastingly, claims 1 and 41 do not contain any explicit limitations or terms regarding a user, a user request, a user selecting a remote location, or a receiving system and thus are not limited to user-selected locations—the only limitation is that the location be remote from the transmission system. This is confirmed by the Examiner's construction of claim 33 in the '720 patent application, as discussed below.

Defendants are arguing that the Court should import a limitation from claims 19 and 47 (that a user request specify a selected remote location) into claims 1 and 41, which do not contain such a limitation. Adoption of defendants' construction would

[3] Defendants argue that, in claim 19, the term "remote locations" used in the preamble, provides antecedent basis for the phrase "one of the remote locations selected by a user" in the "sending a request. . ." claim step. Defendants focus on the portion of this phrase "the remote locations," but ignore the portion "selected by the user." The phrase "one of the remote locations selected by a user" is part of the step of "sending a request . . ." Therefore the antecedent basis for the phrase "selected by the user" is found in the phrase "sending a request," not in the phrase "remote locations," because the identity of the location selected by the user is in the request which is sent by the user.

violate the doctrine of claim differentiation. "It is settled law that when a patent claim does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim in determining either validity or infringement." SRI International v. Matsushita Electric Corporation of America, 775 F.2d 1107, 1122 (Fed. Cir. 1985); Amgen, Inc. v. Hoescht Marion Roussel, Inc., 314 F.3d 1313, 1325 (Fed. Cir. 2003). Defendants cannot rewrite the claim phrase "remote locations" to add limitations that simply do not exist in the claim. Texas Instruments, 988 F.2d at 1171 ("'courts can neither broaden nor narrow claims to give the patentee something different than what he has set forth.'"); Hoganas AB v. Dresser Industries, Inc., 9 F.3d 949, 950, 1578 (Fed. Cir. 1993) ("It is improper for a court to add 'extraneous' limitations to a claim, that is, limitations added 'wholly apart from any need to interpret what the patentee meant by particular words or phrases in a claim.'"); Renishaw PLC v. Marposs Societa A'Per Azoni, 158 F.3d 1243, 1249 (Fed. Cir. 1995) ("We know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim . . . , we should never know when to stop.") (citing McCarty v. Lehigh Valley R.R., 160 U.S. 110, 116 (1895)).

The use of the phrase "remote locations" by the inventors in its ordinary and accustomed meaning with reference to the transmission system described in claims 1 and 41 is further supported by the use of differentiating words in other claims. In claims 19 and 47, the inventors intended to claim a method and system which was limited so that the request sent by the user would identify a reception system at a selected remote location and the information would be transmitted to this location. The inventors still used the phrase "remote locations" in its ordinary and customary manner, but added words which create limitations that the request would include the identity of the reception system at a remote location selected by the user and that the information would be sent to, stored, and played back at the receiving system at the

4) "Location" in the Context of a User "Selected Remote Location" Means "Premises"

- The specification teaches that, in context of selecting a remote location, "location" means "premises":

> The Walter patent discloses a fully dedicated, multi-conductor, optical cable system that is wired to the viewer's **premises**... The Walter system further requires the viewer be at **that location** for both ordering and viewing the audio/video material. **[col. 1, lines 21-29]**

- Applicants admitted to the PTO that the specification teaches that "selected remote location" means "selected remote premises":

> **Notably, Applicants have used the term "location" to refer to a premises rather than merely space in a particular structure**. For example, Applicants distinguished U.S. Patent No. 4,506,387, issued to *Walter* ("the *Walter* patent") [in the specification] based upon the fact that the system disclosed in the *Walter* patent requires a dedicated cable wired to the viewer's **premises** and that the viewer be at that **location** for both ordering and viewing the audio/video material.

(Reply and Amendment Under 37 C.F.R. 1.111, June 7, 1999, p. 7, Benyacar Decl., Ex. J.)

- Contrary to Acacia's argument, the Court never rejected this construction
  - The Court previously determined only that applicants' admissions, directed to the "location" the user selects for reception of the requested information, does not apply to "location" of the transmission system

Acacia's Construction Of How A User Selects A Remote Location

"Time Warner subscribers may have more than one outlet in their home for connecting a set top box to the cable network, each outlet being in a different remote location (e.g., living room, bedroom). By selecting a particular outlet for a set top box within their home, the Time Warner subscriber has selected a location (e.g., living room), which is remote from the transmission system."

- Acacia's infringement contentions to Time Warner Cable Inc. (p. 10)

TAB 11

“A Distribution Method Responsive To Requests From A User Identifying Items In A Transmission System Containing Information”

Point I Of Round 3 Defendants’ Brief (Part I)

The Preamble of Claim 19 Limits the Claim

- Claim 19's Preamble Provides Antecedent Basis For 4 Different Limitations In The Body Of The Claim
  - In *C.R. Bard* and *Vaupel*, relied on by Acacia, the preambles did not provide antecedent basis for claim limitations
    - ⇨ "housing" (Bard) and "breast beam" (Vaupel) were not even limitations in the body of the claims
  - In contrast, there is no dispute that "transmission system, "user," "remote location," and "receiving system" are limitations of claim 19
  - This case is like *Bell Communications Research* and *Electro Scientific Industries*, where the preambles did provide antecedent basis for claim limitations
    - ⇨ "packet" (*Bell Communications Research*) and "circuit board" (*Electro Scientific Industries*) were claim limitations
- Claim 19's Preamble Recites The Important Step That User Requests Identify Physical Items Containing Information In The Source Material Library
  - The specification teaches the importance of this limitation
  - Prior art was distinguished during prosecution based on this limitation
  - This limitation is found in the body of other claims of the '992 patent
  - This limitation is found in the body of claims of other Yurt patents
  - Patentee distinguished prior art during prosecution because it did not teach, in order:
    1. a user request for information (to the source material library);
    2. storing the information (in the compressed data library);
    3. transmitting the information to the user
- Claim 19's Preamble Was Amended To Specify That User Requests Identify Physical Items
- Claim 20 Treats The Preamble Of Claim 19 As A Limitation By Narrowing It

Claim 19's Preamble Provides Antecedent Basis For 4 Different Limitations In The Body Of The Claim

In *C.R. Bard*, relied on by Acacia, the preamble did not provide antecedent basis for claim limitations

21. A biopsy needle **for use with a tissue sampling device having a housing** with a forward end, a first slide mounted for longitudinal motion within said housing, and a second slide mounted for longitudinal motion within said housing, said biopsy needle comprising:

a hollow first needle having proximal and distal ends;

a second needle extending through said hollow first needle and freely slidable therewithin, said second needle having proximal and distal ends;

a first head mounted to said proximal end of said hollow first needle, said first head including first flange means associated therewith for coupling said hollow first needle to said first slide for longitudinal motion both toward and away from said forward end of **said housing**; and

a second head mounted to said proximal end of said second needle, said second head including second flange means associated therewith for coupling said second needle to said second slide for longitudinal motion both toward and away from said forward end of **said housing**.

Holding: the "housing" is not even a limitation in the body of the claim:

> the preamble of claim 21 recites the portion and structure of the gun housing into which the needles fit, and provides reference points in the gun that aid in defining the needles as set forth in the body of the claim... **the gun structure is not part of the separate claims to needles**. (p. 1350)

Claim 19's Preamble Provides Antecedent Basis For 4 Different Limitations In The Body Of The Claim

In *Vaupel*, relied on by Acacia, the preamble did not provide antecedent basis for claim limitations

1. A method of forming a plurality of patterned strips of fabric woven from threads of synthetic material using a broad weaving machine having a sley and a **breast beam**, which method comprises:

   weaving on the broad weaving machine a unitary broad fabric with said strips to be formed extending in parallel relation along the warp direction of said fabric;

   conveying said fabric from the position where the sley of said machine beats up the fabric at a sufficiently low warp tension that a boxing condition occurs to obviate weft arching;

   guiding the woven fabric leaving the position where the sley beats up the fabric to allow movement towards **the breast beam** of said machine, but not in the opposite direction;

   cutting the guided woven fabric in the warp direction with a heated cutting blade means maintained at a first temperature of at least about 300°C to form strips whereby the edges are welded by the heat and thereby avoids ripping;

   separating said strips;

   and thereafter further heating the entire body of said separated strips at a second temperature lower than said cutting temperature to relieve varying tensile stress therein by thermostabilization.

Holding: "Breast beam" is not even a limitation in the body of the claim. (p. 880)

Claim 19's Preamble Provides Antecedent Basis For 4 Different Limitations In The Body Of The Claim

This case is like *Bell Communications Research*,
where the preamble did provide antecedent basis for a claim limitation ("Packet")

6. A method for transmitting **a packet** over a system comprising a plurality of networks interconnected by gateways, said packet originated by a source device connected to one of said networks and destined for a destination device connected to one of said networks, **said packet including a source address and a destination address**, and said method comprising the steps of

   defining an undirected graph representative of the system wherein said networks comprise graph nodes and said gateway[s] comprise graph paths,

   defining a spanning tree on said graph such that every pair of said nodes is connected by only one of said paths and selecting a plurality of spanning trees for said graph according to predetermined system guidelines,

   configuring each gateway with source address lists in correspondence to the number of trees having said each gateway comprising one of said paths, wherein said lists reduce to a common list whenever said selection of spanning trees results in identical ones of said lists for said each gateway,

   assigning, by said source device, one of said trees to broadcast **said packet** and associating with **said packet** an identifier indicative of said one of said trees,

   broadcasting **said packet** by said source device through the system on said one of said trees, and

* * *

Holding: The claim requires that packets have source and destination addresses:

> These two steps of the claimed method, by referring to "*said* packet," expressly incorporate by reference the preamble phrase "said packet including a source address and a destination address." As a result, only a method for transmitting packets that have *both* source *and* destination addresses can literally infringe [the claim]. (p. 621.)

Claim 19's Preamble Provides Antecedent Basis For 4 Different Limitations In The Body Of The Claim

This case is like *Electro Scientific Industries*, where the preamble did provide antecedent basis for a claim limitation ("Circuit Board")

22. In a tool positioning system that is implemented as part of a workpiece processing system in which the workpieces are **electronic circuit boards**, the tool positioning system carrying out a method for cutting a predetermined hole pattern in **at least first and second substantially identical circuit boards each having at least a first conductor layer, a dielectric layer, and a second conductor layer**, comprising:

generating at least first and second laser beams having respective first and second wavelengths;

mounting **the circuit boards** on a slow positioner stage that effects a large range of relative movement between the laser beams and **the circuit boards**;

providing at least first and second fast positioner stages that are coupled to the slow positioner stage to effect small ranges of relative movement between the laser beams and associated ones of **the circuit boards**; and

coordinating the large and small ranges of relative movement such that the first laser beams cuts the predetermined hole pattern in the first conductor layer of the first circuit board while the second laser beam cuts the predetermined hole pattern in the dielectric layer of the second circuit board.

Holding: The claim requires that circuit boards have "at least first and second substantially identical circuit boards each having at least a first conductor layer, a dielectric layer, and a second conductor layer":

> The preamble defines "circuit boards" as "at least first and second substantially identical circuit boards each having at least a first conductor layer, a dielectric layer, and a second conductor layer." References throughout the rest of the claim to "circuit boards" rely upon and derive antecedent basis from this preamble language. Therefore, this preamble definition limits the term "circuit boards" throughout the claim. (p. 1348).

Claim 19's Preamble Recites The Important Step That User Requests Identify Physical Items Containing Information In The Source Material Library

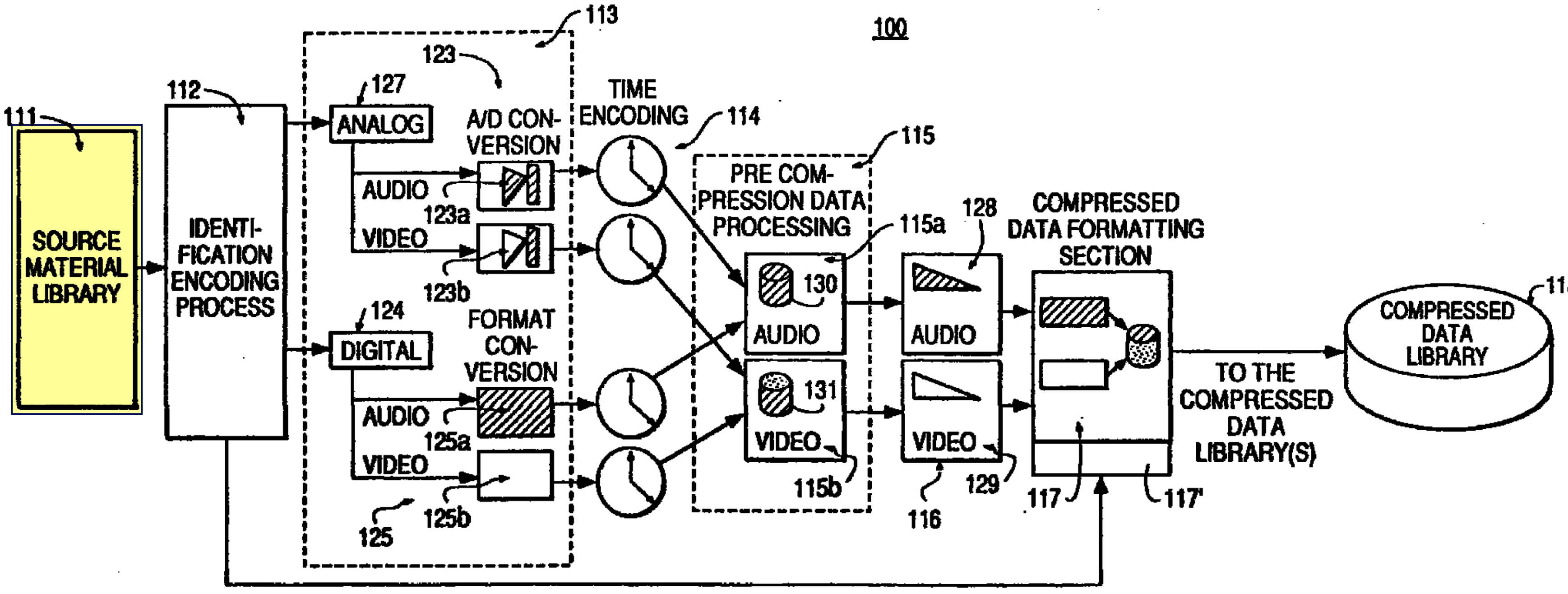
The specification teaches the importance of this limitation

"**the present invention** comprises a receiving system responsive to **a user input identifying a choice of an item stored in a source material library** to be played back to the subscriber at a location remote from the source material library, **the item containing information** to be sent from a transmitter to the receiving system" (2:62-68)

"the first step of the distribution method 400 involves **retrieving the information for (*sic from*) selected items in the source material library 111, upon a request by a user** of the distribution system (step 412)." (18:53-56)

"*Lang* does not disclose a system with one or more libraries wherein a plurality of **system subscribers may access information stored in the film and tape library or libraries**, and play back the selected information at a time and place selected by the subscriber." (1:51-56)

User Requests Identify Physical Items In The Source Material Library



113
100
123
127
112
111
TIME ENCODING
114
ANALOG
A/D CON-VERSION
115
SOURCE MATERIAL LIBRARY
IDENTI-FICATION ENCODING PROCESS
AUDIO
123a
VIDEO
PRE COM-PRESSION DATA PROCESSING
115a
128
COMPRESSED DATA FORMATTING SECTION
130
AUDIO
AUDIO
118
COMPRESSED DATA LIBRARY
123b
124
DIGITAL
FORMAT CON-VERSION
131
VIDEO
VIDEO
TO THE COMPRESSED DATA LIBRARY(S)
AUDIO
125a
VIDEO
115b
129
116
117
117'
125
125b

FIG. 2a

request

"As shown in FIG. 2a, the source material library means included in transmission system 100 preferably includes a source material library 111. The source material library 111 may include different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects." **(col. 6, lines 8-15)**

Claim 19’s Preamble Recites The Important Step That User Requests Identify Physical Items Containing Information In The Source Material Library

Prior art was distinguished during prosecution based on this limitation

“Lang does not teach that user requests will cause items stored in a source material library to be sent from a transmitter to a receiving system” (Petition to Make Special p. 7)

“The entire system includes a transmission system and a reception system. The transmission system includes a source material library from which a user makes a selection. The selected program is processed and compressed for storage in a compressed data library.” (Petition to Make Special pp. 2-3)

Claim 19's Preamble Recites The Important Step That User Requests Identify Physical Items Containing Information In The Source Material Library

This limitation is found in the body of other claims of the '992 patent

25. A receiving system responsive to **a user input identifying a choice of an item stored in a source material library** at a transmission system to be played back to a user at a location remote from the source material library, **the item containing information** to be sent from the transmission system to the receiving system, the receiving system comprising:

requesting means for transmitting to the source material library in the transmission system the identity of the item;

* * *

54. A method of receiving information at a receiving system from a transmission system which information is responsive to an **input from a user, the input identifying a choice of an item stored in a source material library** to be played back to the user at a receiving system at a location remote from the source material library, **the item containing information** to be sent from the transmission system to the receiving system, the receiving method comprising the steps of:

transmitting the identity of an item from the user to the source material library at the transmission system;

Claim 19's Preamble Recites The Important Step That User Requests Identify Physical Items Containing Information In The Source Material Library

This limitation is found in the body of claims of other Yurt patents

'275 patent claim 3: A receiving system responsive to **a user input identifying a choice of an item stored in a source material library** at a transmission system to be played back to a user at a location remote from the source material library, **the item containing information** to be sent from the transmission system to the receiving system, the receiving system comprising:

requesting means for transmitting to the source material library in the transmission system the identity of the item;

* * *

'275 patent claim 6: A receiving system responsive to **a user input identifying a choice of an item stored in a source material library** at a transmission system to be played back to a user at a location remote from the source material library, **the item containing information** to be sent from the transmission system to the receiving system, the receiving system comprising:

requesting means for transmitting to the source material library in the transmission system the identity of the item;

* * *

'863 patent claim 3: A receiving system responsive to **a user input identifying a choice of an item stored in a source material library** at a transmission system, **the item containing information** to be sent from the transmission system to the receiving system, the receiving system comprising:

requesting means for transmitting to the source material library in the transmission system the identity of the item;

* * *

'863 patent claim 6: A receiving system responsive to **a user input identifying a choice of an item stored in a source material library** at a transmission system, **the item containing information** to be sent from the transmission system to the receiving system, the receiving system comprising:

requesting means for transmitting to the source material library in the transmission system the identity of the item;

Claim 19's Preamble Recites The Important Step That User Requests Identify Physical Items Containing Information In The Source Material Library

Patentee distinguished prior art during prosecution because it did not teach, in order:
1) **A user request for information (to the source material library);**
2) **storing the information (in the compressed data library);**
3) **transmitting the information to the user**

"There is no provision in *Stetten* et al. for **storing requested information after selection and prior to transmission**." (Petition to Make Special p. 16)

"**After selection from memory modules, there is no provision in Walter for storing the requested material in a compressed form**." (Petition to Make Special p. 10).

"*Boulton* et al. also does not show **the requested information being stored prior to transmission to a user**." (Petition to Make Special p. 12)

"In *Gordon et al.*, there is no provision **for storage of requested programming before transmission to the user**…" (Petition to Make Special p. 14)

"[In *Lambert*] there is no provision for **storage of requested data prior to transmission**…" (Petition to Make Special p. 15)

"[In *Okada*] [t]here is no provision for **storage of the requested information prior to transmission** …" (Petition to Make Special p. 19)

"In *Nakajima et al.*, the subscriber request is processed and the information is sent directly to the subscriber terminal. **There is no provision for storage of the requested information prior to transmission to the user**…" (Petition to Make Special p. 21)

"[In *Lovett*] [t]here is no provision for **storage of the requested information prior to transmission** …" (Petition to Make Special p. 22)

"[In *Yabiki*] [t]here is no provision for **storage of the requested information prior to transmission**…" (Petition to Make Special p. 24)

"With the system in *Abraham* '512... there is **no provision for storage of the requested program prior to transmission**…" (Petition to Make Special p. 25).

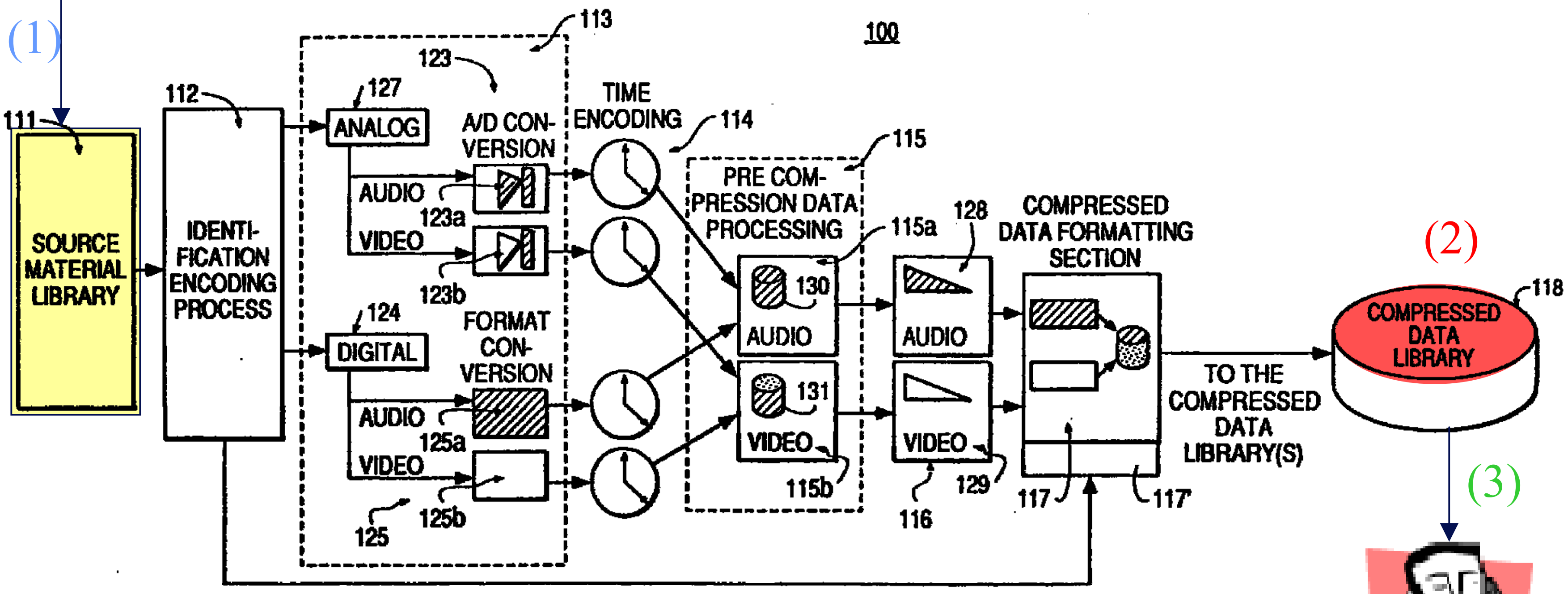
"In *Abraham* '806...**the requested information is not stored prior to transmission**…" (Petition to Make Special p. 26)

Patentees Distinguished Prior Art During Prosecution Because It Did Not Teach, In Order:

(1) A User Request For Information (To The Source Material Library);

(2) Storing The Information (In A Compressed Data Library);

(3) Transmitting The Information To The User



(1)
(2)
(3)
100
111
SOURCE MATERIAL LIBRARY
112
IDENTI-FICATION ENCODING PROCESS
113
123
127
ANALOG
A/D CON-VERSION
AUDIO
123a
VIDEO
123b
124
DIGITAL
FORMAT CON-VERSION
AUDIO
125a
VIDEO
125
125b
TIME ENCODING
114
115
PRE COM-PRESSION DATA PROCESSING
115a
130
AUDIO
131
VIDEO
115b
128
AUDIO
VIDEO
129
116
COMPRESSED DATA FORMATTING SECTION
117
117'
TO THE COMPRESSED DATA LIBRARY(S)
118
COMPRESSED DATA LIBRARY

FIG. 2a

Claim 19's Preamble Was Amended To Specify That User Requests Identify Physical Items

December 10, 1991 Office Action:

- Claim 19 (application claim 18) rejected as obvious over Abraham, Ulicki, and Keith prior art references. (Benyacar Dec. Ex. C, p. 3.)

December 20, 1991 Interview Summary:

- "Examiner provides comments about ['992 claim 19]. Examiner will reconsider the allowability of the claims upon the submission of the amendments." (Benyacar Decl. Ex. D.)

December 26, 1991 Amendment:

- Claim 19 preamble amended as follows:

> A distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from [a] the transmission system to receiving systems at remote locations, the method comprising the steps of:
> (Benyacar Dec. Ex. F, p. 2.)

- Applicants represented that the claim amendments were made at the examiner's direction in order to obtain allowance (Benyacar Decl. Ex. F, p. 10.):

> Applicants thank Examiner Chin very much for the courtesy of the interview held on December 20, 1991. **This amendment reflects the suggestions made by the Examiner to place the claims in better form for allowance** and to eliminate any problems under 35 U.S.C. 112, paragraph 1.

Claim 20 Treats The Preamble Of Claim 19 As A Limitation By Narrowing It

19. A distribution method responsive to requests from a user identifying **items** in a transmission system **containing information** to be sent from the transmission system to receiving systems at remote locations, the method comprising the steps of:

* * *

20. The distribution method as recited in claim 19, wherein **the information in the items includes analog and digital signals**, and wherein the step of storing the information comprises the steps, performed by the transmission system, of:

The Construction Of The Preamble As A Whole

The Preamble

"**A distribution method responsive to requests from a user identifying items in a transmission system containing information**"

Construction

"**A user request must contain an identifier of physical items containing information that has not yet undergone the compression recited in the first "storing" step. The physical items must be in the transmission system such that this information can be retrieved from the physical items in response to user requests**."

– the first storing step requires that compression occur on information "from items," meaning the information contained in the items is not yet compressed

TAB 12

“Storing, in the Transmission System, Information From Items in a Compressed Data Form, the Information Including an Identification Code and Being Placed Into Ordered Data Blocks”

Point II Of Round 3 Defendants’ Brief (Part I)

Claim Term

"storing, in the transmission system, information from items in a compressed data form, the information including an identification code and being placed into ordered data blocks"

Construction

The following steps must be performed, in the stated order:

i. obtaining information, including an (one) identification code, from the plurality of (two or more) physical items which identifies all of the information retrieved from the plurality of items;

ii. placing the information that is obtained from the plurality of physical items into a single set of ordered data blocks;

iii. compressing the information which is in the single set of ordered data blocks; and

iv. storing the compressed information "in the transmission system."

"Obtaining" The Information Is A Claim Limitation

Claim Term

"**storing**, in the transmission system, **information from items** in a compressed data form, the information including an identification code and being placed into ordered data blocks"

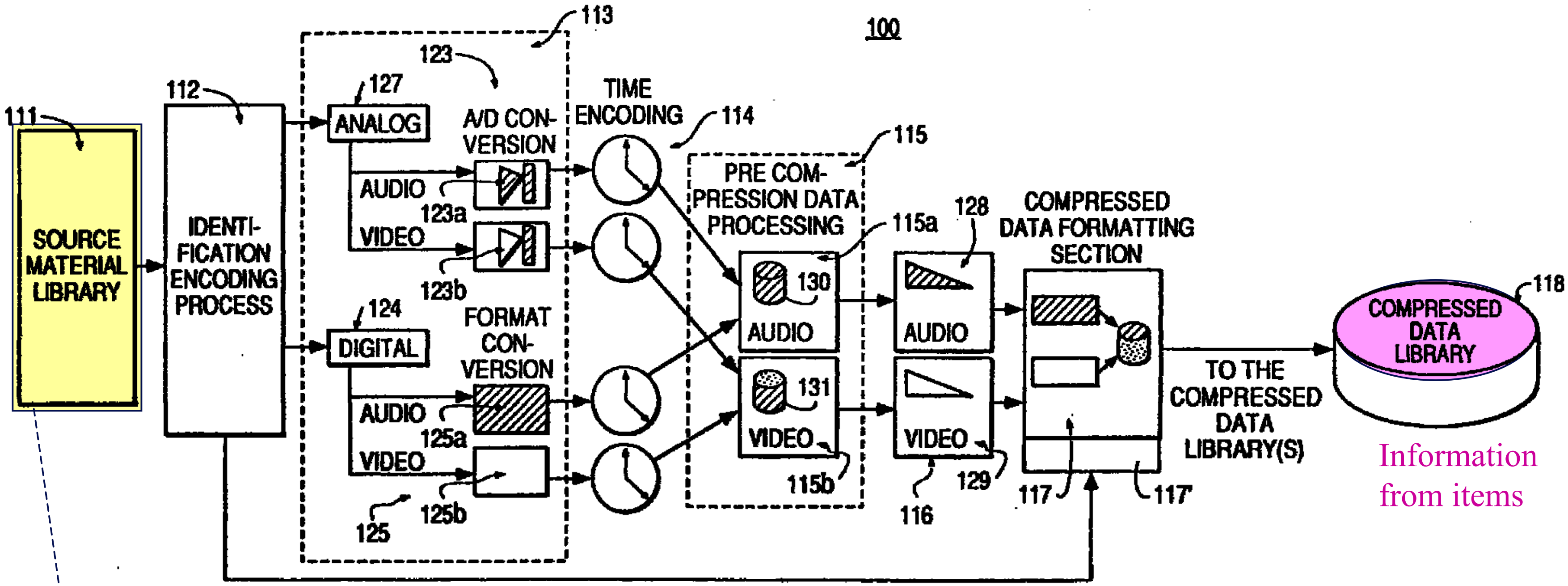
Construction

i. **obtaining information**, including an (one) identification code, from the plurality of (two or more) physical items which identifies all of the information retrieved from the plurality of items;

Explanation

- this claim element requires that the steps be performed on "information from items"

Information From Items Must Be Obtained From Source Material Library



100
111
SOURCE MATERIAL LIBRARY
112
IDENTI-FICATION ENCODING PROCESS
113
123
127
ANALOG
A/D CON-VERSION
AUDIO
123a
VIDEO
123b
124
DIGITAL
FORMAT CON-VERSION
AUDIO
125a
VIDEO
125b
125
TIME ENCODING
114
115
PRE COM-PRESSION DATA PROCESSING
115a
130
AUDIO
131
VIDEO
115b
128
AUDIO
VIDEO
129
116
COMPRESSED DATA FORMATTING SECTION
117
117'
TO THE COMPRESSED DATA LIBRARY(S)
118
COMPRESSED DATA LIBRARY
Information from items

FIG. 2a

Source Material Library
(physical items containing information)

The Claim Covers Obtaining Information From a Plurality (Two or More) of Physical Items That Includes One (and Only One) Identification Code

Claim Term

"storing, in the transmission system, information from **items** in a compressed data form, the information including **an identification code** and being placed into ordered data blocks"

Construction

i. obtaining information, including **an (one) identification code**, from the **plurality of (two or more) physical items** which identifies all of the information retrieved from the plurality of items;

Explanation

- Claim requires that the information be from items plural (two or more items)
  - Acacia agrees: "This claim phrase refers to information from item*s* (plural)" (Acacia Opening Br. p. 11)
- Claim is broad enough to cover one (and only one) identification code
  - Acacia agreed: "the correct construction of "an" [in the phrase "an identification code"] is 'one or more.'" (Acacia Opening Br. p. 12)

One Identification Code Identifies All Of The Information Obtained From The Plurality (Two Or More) Of Items

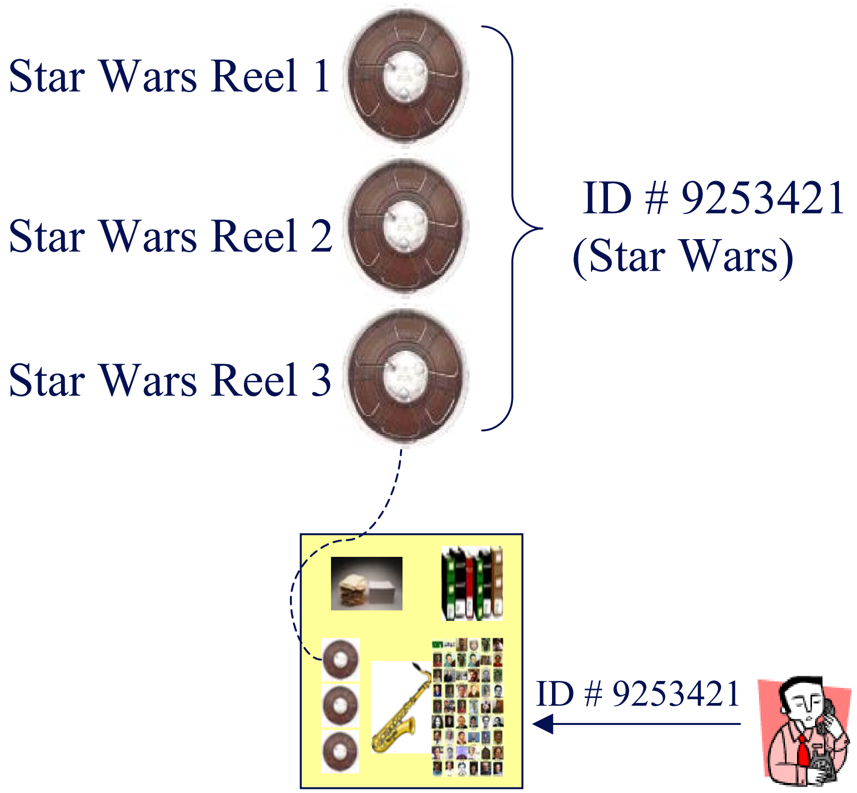
- The specification does not describe how many physical items are used to store information that users request as a single entity
- An identification code can be associated with “The Works of William Shakespeare,” which users could request as a single entity
- Individual movies are always stored on a plurality of reel-to-reel tapes
- If Acacia is correct that “the claim does not state what the identification code identifies” (Acacia Reply Br. p. 12), then the term “identification code” is indefinite.
- If Acacia is correct that the specification discloses only one identification code per item (Acacia Opening Br. pp. 12-13), then the claim lacks written description
  - claim broad enough to cover one and only one identification code (“an identification code”) for a plurality of items
  - the full scope of claim must be supported by the specification. *Regents of the Univ. of Calif. V. Eli Lilly and Co.*, 119 F.3d 1559 (Fed. Cir. 1997); *In re Wilder*, 736 F.2d 1516 (Fed. Cir. 1984)

User Request For Information Stored In Multiple Physical Items Identified By Single Identification Code

Book Example

ID # 8253421
(Works of William
Shakespeare)
ID # 8253421

Movie Example


Star Wars Reel 1
Star Wars Reel 2
Star Wars Reel 3
ID # 9253421
(Star Wars)
ID # 9253421

The Identification Code Must Have Been Obtained From (*i.e.* It Must Have Been Stored In) The Physical Items

Claim Term

"storing, in the transmission system, **information from items** in a compressed data form, **the information including an identification code** and being placed into ordered data blocks"

Construction

i. **obtaining information, including an (one) identification code, from** the plurality of (two or more) **physical items** which identifies all of the information retrieved from the plurality of items;

Explanation

- claim expressly requires that the information obtained from the physical items "includ[es]" an identification code
- the identification code must therefore have been stored in the physical items

"Placing" and "Compressing" Are Claim Limitations

Claim Term

"storing, in the transmission system, **information from items** in a compressed data form, **the information** including an identification code and **being placed into ordered data blocks**"

Construction

ii. placing the information that is obtained from the plurality of physical items into a single set of ordered data blocks;

iii. compressing the information which is in the single set of ordered data blocks

Explanation

- "Being placed" is an action which is presently ongoing as part of the storing step
- All parties agree that compression occurs after "placing" - compression must therefore also be performed as part of the storing step
- Claim 20 makes no sense unless "placing" and "compressing" are part of the storing step
  - If, as Acacia alleges, "placing" and "compressing" occur before the "storing" step begins (Acacia Opening Br. p. 11), claim 20 could not refer to those steps as being part of the storing step
  - "placing" and "compressing" are included in claim 20 to define the order in which those steps occur in relation to the "converting" and "formatting" steps of claim 20, not because "placing" and "compressing" are not limitations of claim 19

19. A distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from the transmission system to receiving systems at remote locations, the method comprising the steps of:

storing, in the transmission system, information from items in a compressed data form, the information including an identification code and being placed into ordered data blocks;

* * *

20. The distribution method as recited in claim 19, wherein the information in the items includes analog and digital signals, and **wherein the step of storing the information comprises the steps**, performed by the transmission system, of:

converting the analog signals of the information to digital components;

formatting the digital signals of the information;

ordering the converted analog signals and the formatted digital signals into a sequence of addressable data blocks and;

compressing the ordered information.

TAB 13

“Time Requested by the User”

Point IV(A) Of Round 3 Defendants’ Brief (Part I)

The User Request For Information Must Contain An Actual Time

Claim Term

"at a time requested by the user"

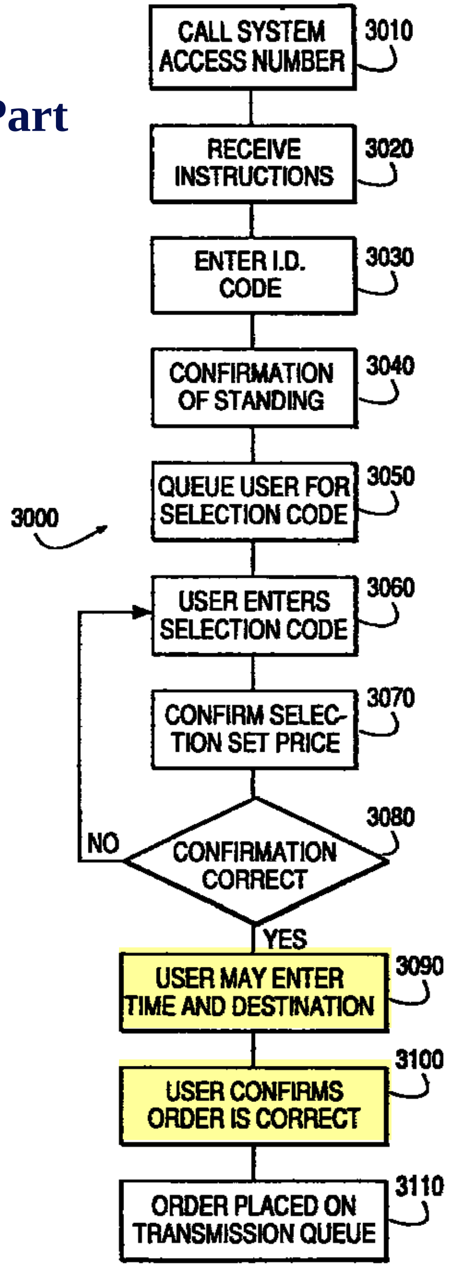
Construction

The request by the user to the transmission system "for at least a part of the stored information" must include a specific time supplied by the user specifying when playback is desired. (Systems which permit users only to request "play" for immediate playback do not satisfy this limitation.)

Explanation

- Plain language of "time requested by the user" means that the user actually makes a "request" that includes a clock time when the information should be played.
- "After the desired item is found, the user selects the item for transmission at a specific time and location." (Col. 15:20-22.)
- The specification also states that the user actually enters a clock time:
  - the user "*inputs* a desired delivery time and location" (Col. 14:32-33),
  - the user "*enters* the playback time and destination" (Col. 14:39-40)
  - the user "*indicates* the desired delivery time and destination" (Col. 14:60-61).

User Enters "Time" And "Destination" As Part Of The User's "Order" For Information


CALL SYSTEM ACCESS NUMBER
3010
RECEIVE INSTRUCTIONS
3020
ENTER I.D. CODE
3030
CONFIRMATION OF STANDING
3040
QUEUE USER FOR SELECTION CODE
3050
3000
USER ENTERS SELECTION CODE
3060
CONFIRM SELECTION SET PRICE
3070
NO
CONFIRMATION CORRECT
3080
YES
USER MAY ENTER TIME AND DESTINATION
3090
USER CONFIRMS ORDER IS CORRECT
3100
ORDER PLACED ON TRANSMISSION QUEUE
3110
FIG. 3

Explanation (cont'd)

- While Acacia alleges we "assume, without any support, that the person making the request will also be the person viewing the information" (Acacia Reply Br. p. 24), the ONLY support in the specification is that the person making the request will be the person watching it:

> Accordingly, the user may remotely access the transmission system 100 from a location differenct than the location of reception system 200 where the material will be sent and/or played back. Thus, for example, **a user may preferably call transmission system 100 from work and have a movie sent to their house to be played back after dinner or at any later time of their choosing**. **[col. 5, lines 14-21]**

- **Simply pushing a "play" button for immediate playback of information is neither a "request" nor the specification of a time**

- No embodiment is disclosed which allows a user simply to press "play" after the requested information has been stored on the reception system. **Unless the user specifies when requesting the information that he wishes to view it at a later time, it will not be recorded on the reception system at all:**

> In the reception system of the present invention, the user may want to play back the requested item from the source material library 111 at a time later than when initially requested. **If that is the case**, the compressed formatted data blocks from receiver format converter 202 are **stored in storage 203**. (18:14-19.)

- even if the specification did teach such an embodiment, the applicants claimed the embodiment where the user makes a request for playback at a specified time

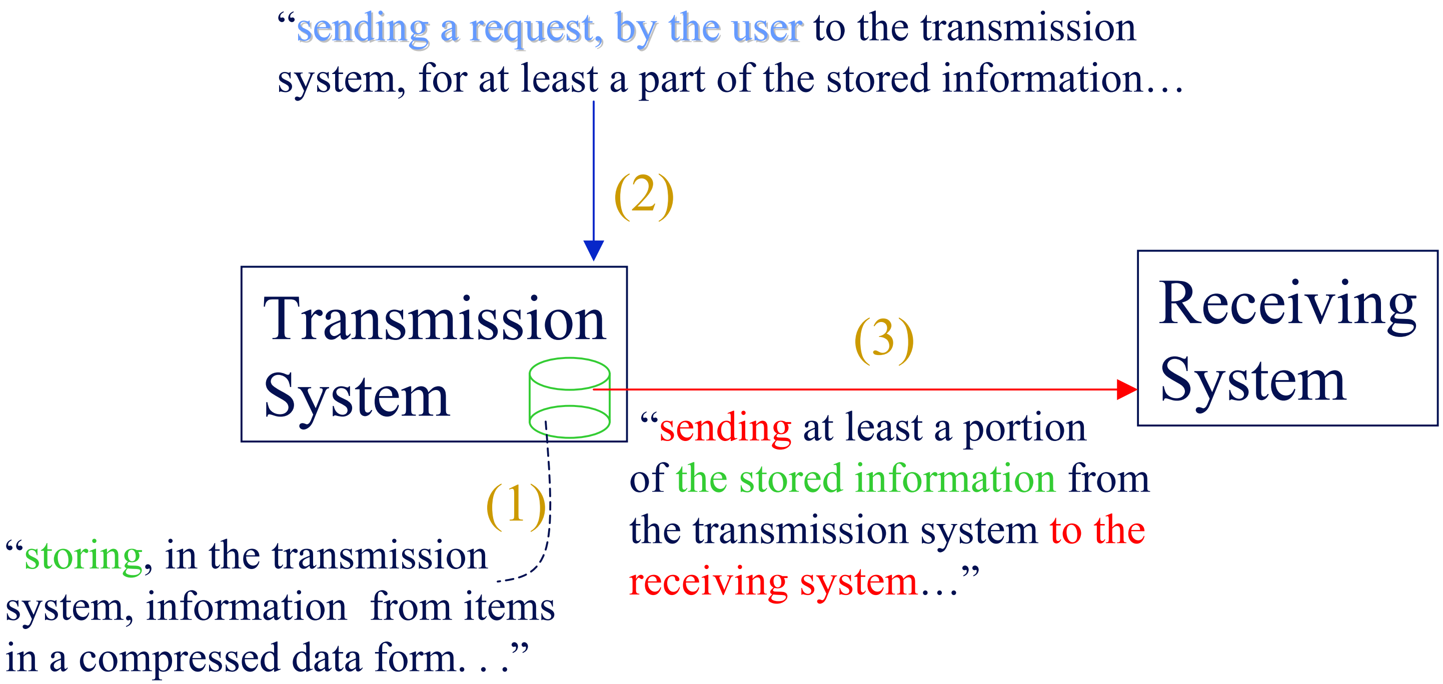
TAB 14

“Sending At Least A Portion Of The Stored Information From The Transmission System”

Point V of Round 3 Defendants’ Brief (Part I)

Sending At Least A Portion Of The Stored Information From The Transmission System

Construction: In response to the user request, at least a portion of the information from items that was stored in the transmission system must be retrieved from the device on which it was stored, then sent



"sending a request, by the user to the transmission system, for at least a part of the stored information…
(2)
Transmission System
(3)
Receiving System
(1)
"storing, in the transmission system, information from items in a compressed data form. . ."
"sending at least a portion of the stored information from the transmission system to the receiving system…"

TAB 15

“Reception System Associated With A Receiving System At One Of The Remote Locations Selected By The User”

Point XXV Round 3 Defendants’ Brief (Part I)

Applicants Represented To the PTO That '275 Claims 2 And 5 Are Directed To "A Reception System Located At the Head End Of a Cable Television System"

LAW OFFICES
NEGAN, HENDERSON
ARABOW, GARRETT
& DUNNER
300 I STREET, N. W.
SHINGTON, DC 20005
1-202-408-4000

REMARKS

This application is a Rule 60 continuation of Serial No. 07/637,562 which was allowed on February 5, 1992.

The amendments to the claims are similar to those made in allowed claims 1, 18, and 22 but add a reception system located at the head end of a cable television system. Support for the amendments to claims 1, 18, and 22 is found at page 9, lines 18-23

-5-

419

Without this construction, "a reception system associated with a receiving system" would be indefinite and would lack written description.

TAB 16

“Playing Back”

Point IV(B) Of Round 3 Defendants’ Brief (Part I)

“Playing Back” Requires Sending Uncompressed Signals To A Playback Device

Claim Term

“playing back”

Construction

“Playback” and “playing back” refer to the process of sending uncompressed signals to a device, such as an audio amplifier and/or television, on which video information can be displayed and/or audio information heard. These terms are construed similarly in other claims of the ‘992 and ‘275 patents.

Explanation

- “playing back” refers to the transmission of the requested information, in uncompressed format, to a device, such as an audio amplifier or television, so that the information can be viewed or heard:
  - As depicted in Fig. 6:

“**When playback is requested**, the compressed formatted data blocks are sent to data formatter **204**. Data formatter **204** processes the compressed formatted data blocks and distinguishes audio information from video information.

The separated audio and video information are respectively **decompressed** by audio decompressor **209** and video decompressor **208**. The decompressed video data is then sent simultaneously to converter **206** including digital video output converter **211** and analog video output converter **213**. The decompressed audio data is sent simultaneously to digital audio output converter **212** and analog audio output converter **214**. The outputs from converters **211-214** are produced in real time. The real time output signals are output to a playback system such as a TV or audio amplifier.” (Col. 18:23-37.)

Explanation (cont'd)

- "[T]he present invention comprises . . . decompressing means, coupled to the receiver format conversion means, for decompressing the compressed formatted information; and output data conversion means, coupled to the decompressing means **for playing back the decompressed information in real time**…" (Col. 2:62 - 3:14.)

- "Copy protected programs, **when decompressed and played back**, would have a copy protection technique applied to the analog and digital output signals." (Col. 5:46-48.)

- Claim 25 of the '992 patent further supports Round 3 defendants definition. It requires "data conversion means, coupled to the decompressing means, for playing back the decompressed copy of the data at a time specified by the user."

- Consistent with dictionary definition of "playback":
  - "the action of reproducing recorded sound or pictures often immediately after recording." Webster's Third New International Dictionary, p. 1737 (2002).
  - "A term used to denote reproduction of a recording." IEEE 100: The Authoritative Dictionary of IEEE Standard Terms, 7^{th} Ed., p. 834, IEEE Press (2000).

TAB 17

“Playing Back The Stored Copy Of the Information From The Reception System To The Receiving System At The Selected Remote Location At A Time Requested By The User”

Point XXVI Of Round 3 Defendants’ Brief (Part I)

“Playing Back … From The Reception System To the Receiving System”

Construction

The “receiving system” must be a device on which playback can occur - a device which itself can display video content or play audio content directly to a user, such as a television or a radio. (The “receiving system” cannot be a set top box.)

Argument

- “playback system” is described in the patent as “a TV or audio amplifier” which can itself display video content or play audio content directly to a user.

- consistent with the definition of “playback” in the dictionaries relied on by Acacia:

  – “the action of reproducing recorded sound or pictures often immediately after recording.” Webster’s Third New International Dictionary, p. 1737 (2002).

  – “A term used to denote reproduction of a recording.” IEEE 100: The Authoritative Dictionary of IEEE Standard Terms, 7th Ed., p. 834, IEEE Press (2000).

- if Acacia is correct that the receiving system need not be a device which can display video content or play audio content directly to a user, then the recorded information is not being reproduced at all, meaning there is no playback.

- A cable television set-top box does not have the capability of displaying video content or playing audio content

TAB 18

CLAIM 23

Points XI And XII Of Round 3 Defendants' Brief (Part I)

Claim 23 Requires That The “receiving system” Be At The Head End

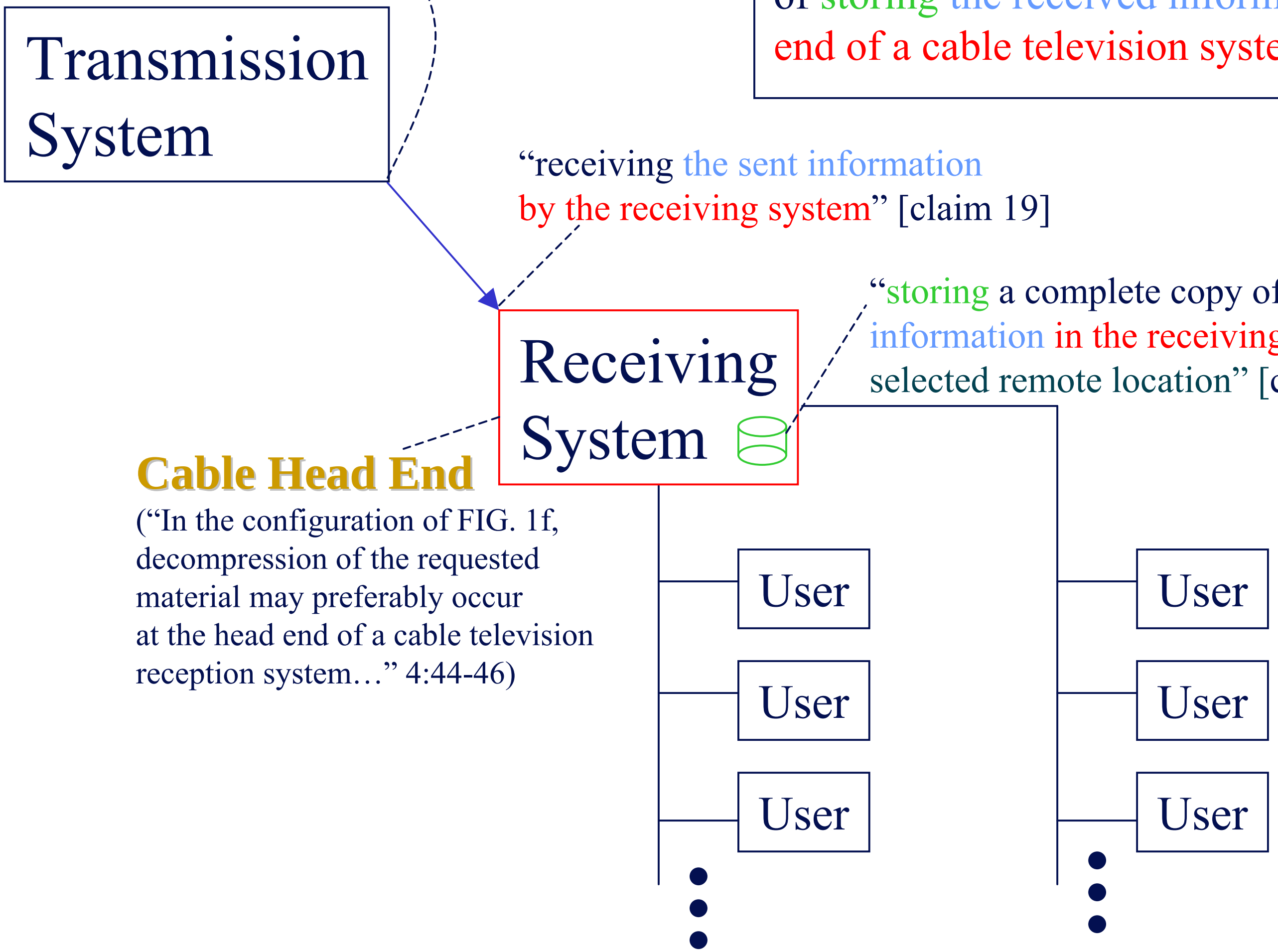
“sending. . . information from the transmission system to the receiving system…” [claim 19]

Claim 23

“wherein the step of storing includes the step of storing the received information at the head end of a cable television system” [Claim 23]

“receiving the sent information by the receiving system” [claim 19]

“storing a complete copy of the received information in the receiving system at the selected remote location” [claim 19]



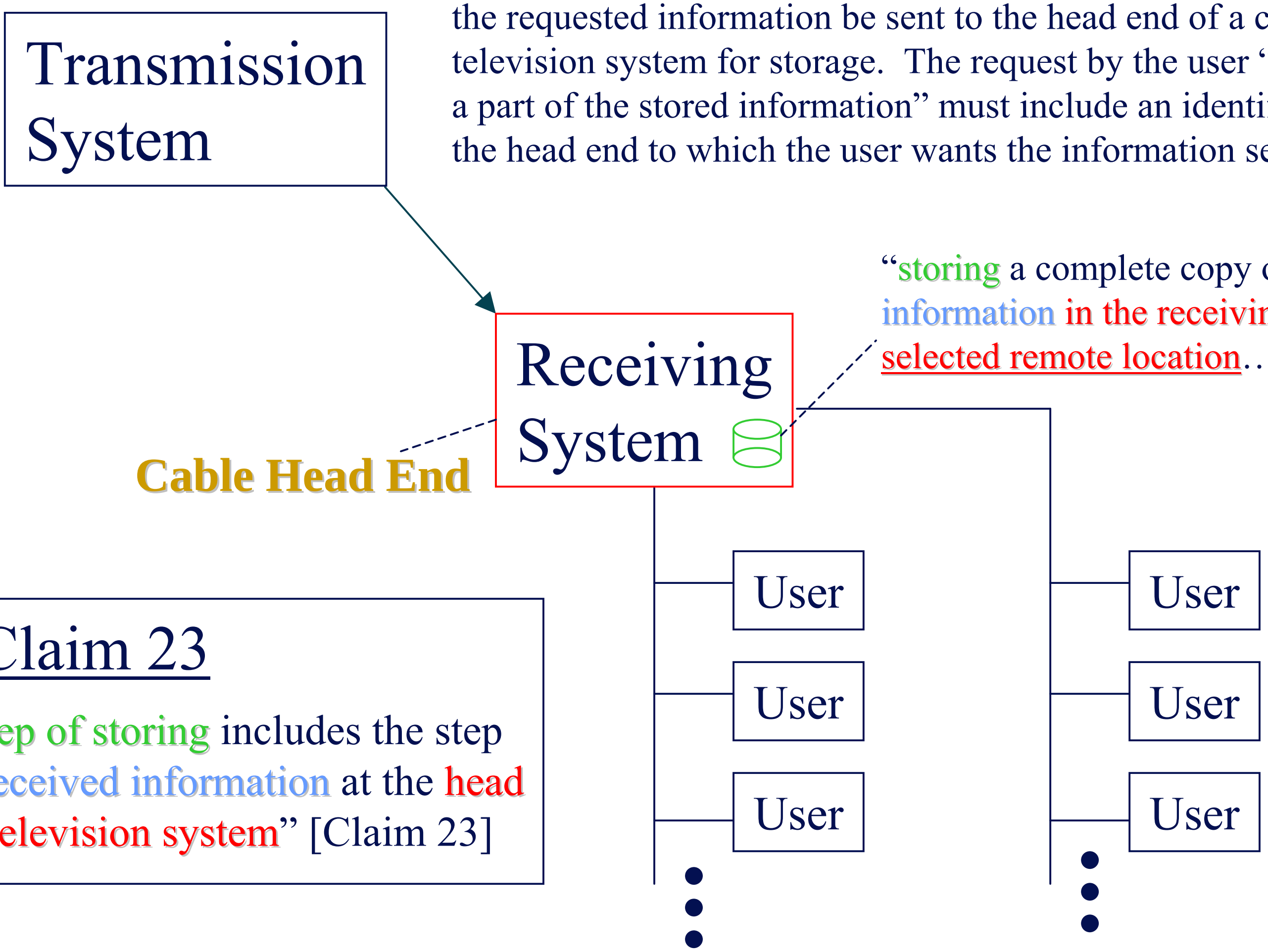
Cable Head End

(“In the configuration of FIG. 1f, decompression of the requested material may preferably occur at the head end of a cable television reception system…” 4:44-46)

Construction Of Claim 23

The head end is the "selected remote location."

When the user selects from among a plurality of (two or more) remote locations having receiving systems, the user selects that the requested information be sent to the head end of a cable television system for storage. The request by the user "for at least a part of the stored information" must include an identification of the head end to which the user wants the information sent.



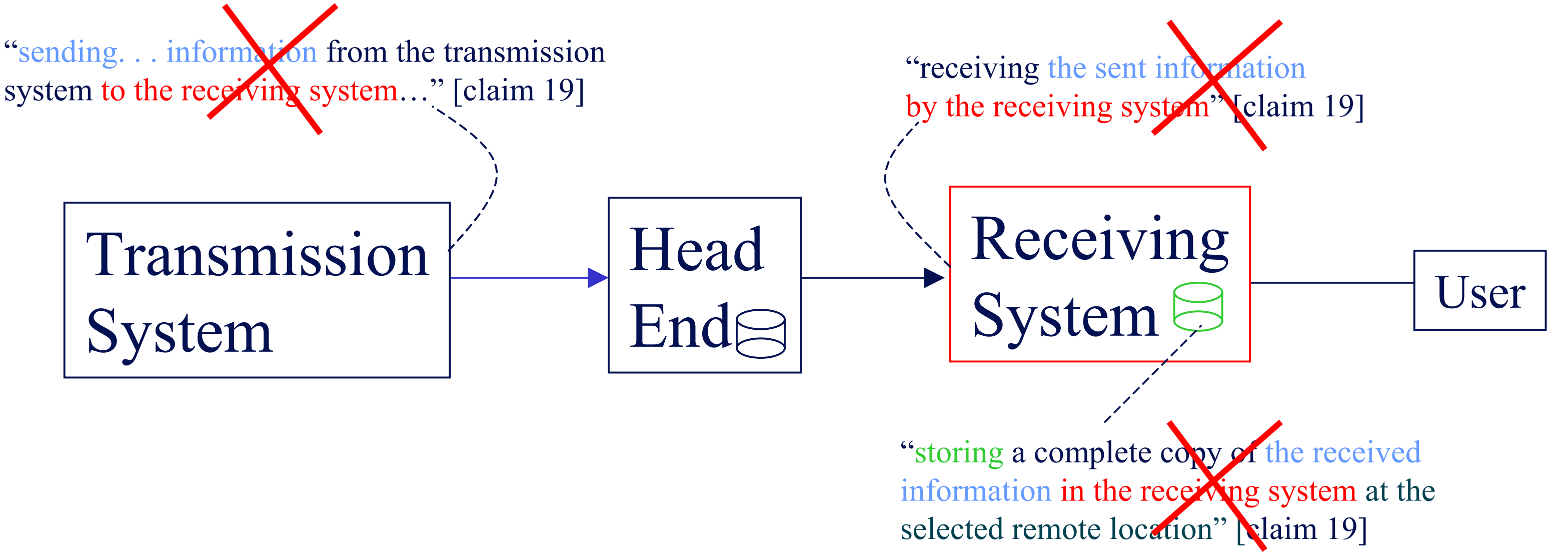
Transmission System
Receiving System
Cable Head End
User
User
User
User
User
User

"storing a complete copy of the received information in the receiving system at the selected remote location…" [claim 19]

Claim 23

"wherein the step of storing includes the step of storing the received information at the head end of a cable television system" [Claim 23]

Acacia's Construction Of Dependent Claim 23 Vitiates Three Limitations Of Claim 19


"sending. . . information from the transmission system to the receiving system…" [claim 19]
"receiving the sent information by the receiving system" [claim 19]
Transmission System
Head End
Receiving System
User
"storing a complete copy of the received information in the receiving system at the selected remote location" [claim 19]

According to Acacia, "[t]he step of claim 23 is performed before the second step of storing of claim 19." Acacia Opening Br. p. 43.)

TAB 19

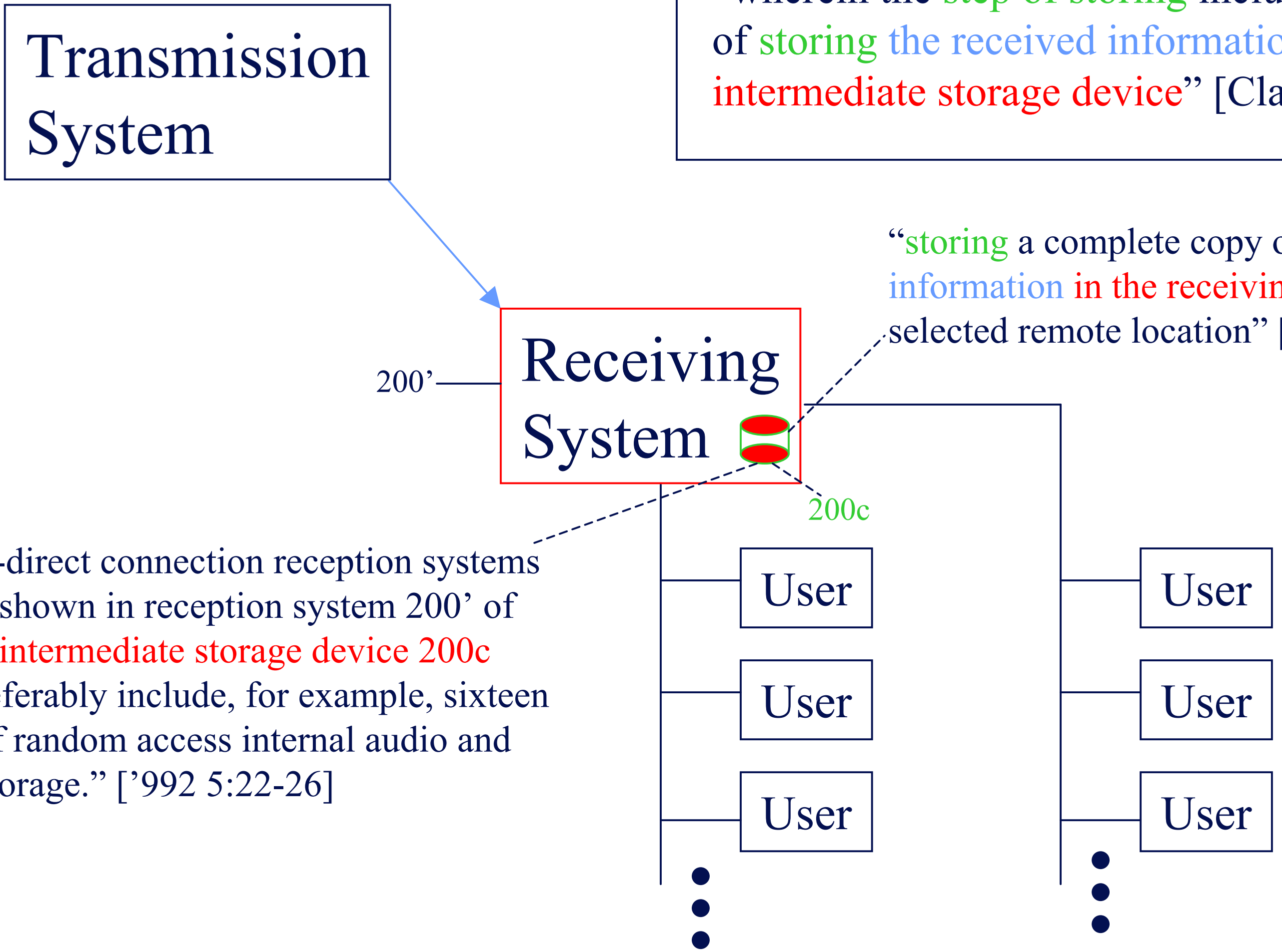
CLAIM 24

Points XIII And XIV Of Round 3 Defendants' Brief (Part I)

Claim 24 Requires That The "intermediate storage device" Be Part Of The "receiving system"

Claim 24

"wherein the step of storing includes the step of storing the received information in an intermediate storage device" [Claim 24]



Transmission System
200'
Receiving System
200c
User
User
User
User
User
User

"storing a complete copy of the received information in the receiving system at the selected remote location" [claim 19]

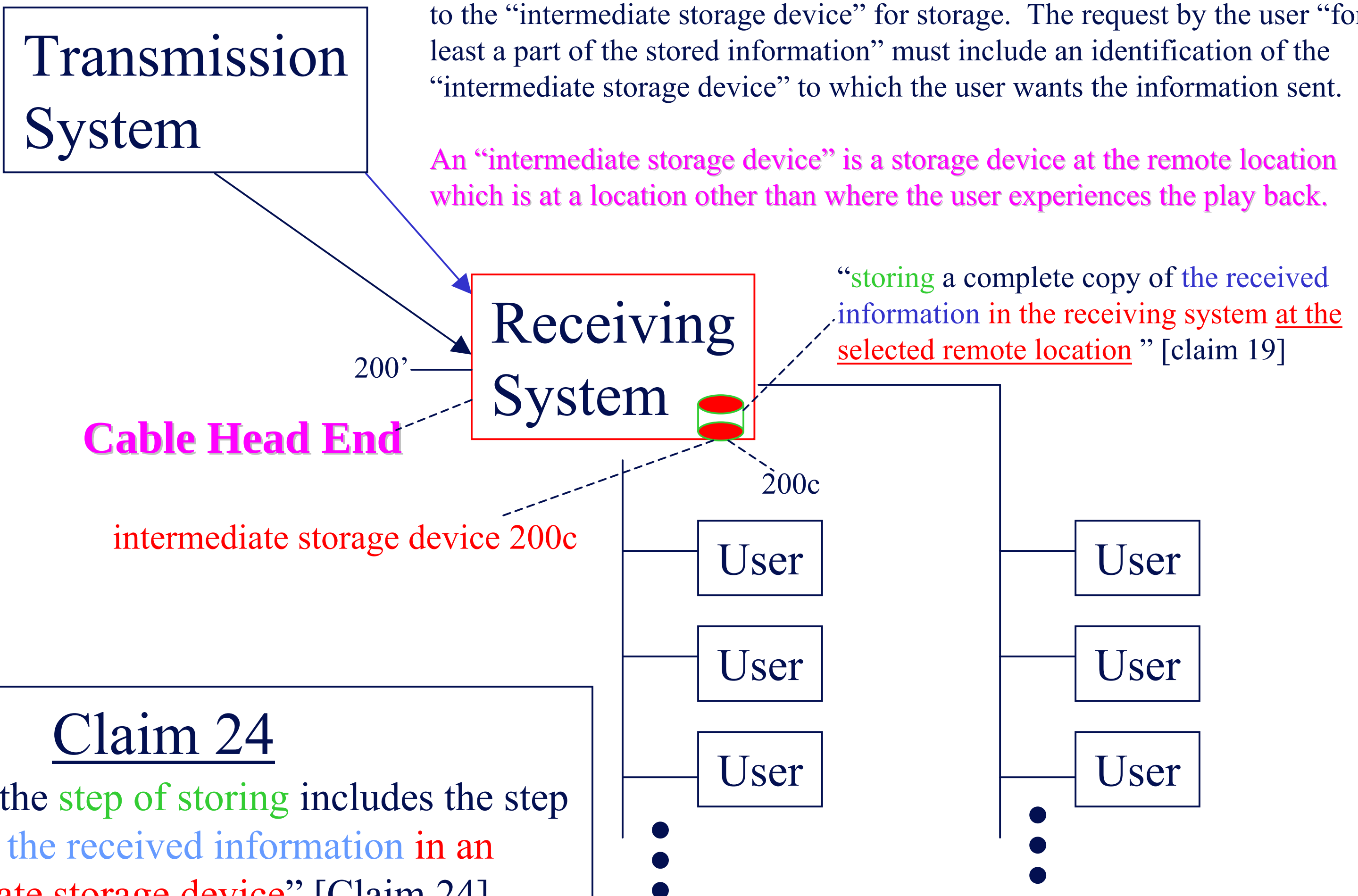
"In non-direct connection reception systems such as shown in reception system 200' of Fig. 1f, intermediate storage device 200c may preferably include, for example, sixteen hours of random access internal audio and video storage." ['992 5:22-26]

Construction of Claim 24

The intermediate storage device is at the "selected remote location."

When the user selects from among a plurality of (two or more) remote locations having receiving systems, the user selects that the requested information be sent to the "intermediate storage device" for storage. The request by the user "for at least a part of the stored information" must include an identification of the "intermediate storage device" to which the user wants the information sent.

An "intermediate storage device" is a storage device at the remote location which is at a location other than where the user experiences the play back.

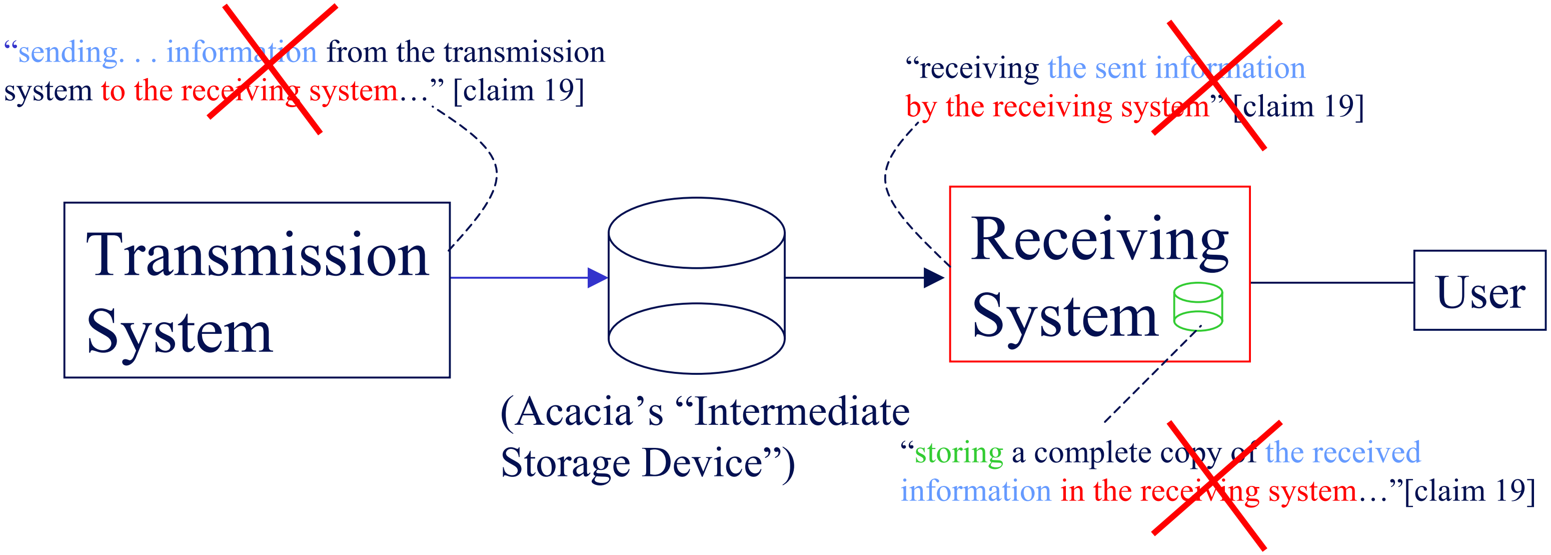


Transmission System
Receiving System
200'
Cable Head End
"storing a complete copy of the received information in the receiving system at the selected remote location" [claim 19]
200c
intermediate storage device 200c
User
User
User
User
User
User

Claim 24

"wherein the step of storing includes the step of storing the received information in an intermediate storage device" [Claim 24]

Acacia's Construction Of Dependent Claim 24 Vitiates Three Limitations Of Claim 19


"sending. . . information from the transmission system to the receiving system…" [claim 19]
"receiving the sent information by the receiving system" [claim 19]
Transmission System
Receiving System
User
(Acacia's "Intermediate Storage Device")
"storing a complete copy of the received information in the receiving system…"[claim 19]

According to Acacia, "[t]he step of claim 24 is performed before the second step of storing of claim 19." Acacia Opening Br. p. 46.)

TAB 20

Order Of The Steps Of Claim 21

Point X of Round 3 Defendants' Brief (Part I)

The Step Of Claim 21 Must Be Performed After Claim 19's First Storing Step

The substep of claim 21 cannot be performed before or simultaneously with claim 19's first storing step because claim 21's "storing" in the "compressed . . . libraries" step requires that the following steps of claim 19 occur first:

- Information "being placed into ordered data blocks"; and
- The data blocks being "compressed"

TAB 21

Order Of The Steps Of Claims 42-44

Point XVIII, XIX and XX of Round 3 Defendants' Brief (Part I)

Steps of Claims 42-44 Must Be Performed During Claim 24's "placing the retrieved information" Step

- Claims 42-44 require that "the step of placing" of claim 41 "further includes" the steps recited in claims 42 - 44
- Claim 41's "step of placing", further defined by claim 42 – 44, result in data being placed into a "predetermined format"
  - Claim 41's "step of placing" requires "placing … into a predetermined format as formatted data"
  - Claims 42 - 44 require "converting … into formatted data with a predetermined format"